

# **SOMETHING OLD, SOMETHING BORROWED, SOMETHING DIGITAL: EXISTING LEGAL PROTECTION OF INDIGENOUS INTANGIBLE CULTURAL HERITAGE**

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# Table of Contents

<b><u>1</u></b>	<b><u>INTRODUCTION</u></b>	<b><u>1</u></b>
<b><u>2</u></b>	<b><u>ISSUES IN EXPLOITATION OF INDIGENOUS INTANGIBLE CULTURAL HERITAGE</u></b>	<b><u>3</u></b>
2.1	Definitions	3
2.2	Outlining the Problem: Exploitation	5
2.2.1	Two Cases of Infringement of Aboriginal Art in Australia	6
2.2.2	The Case of Disparagement: <i>Pro-Football v. Harjo</i>	11
2.2.3	Something of an Enigma: the Case of Lifvon Guo	14
2.2.4	The Right to One's Name and Image: the Twilight Saga	16
2.3	Outlining the Problem: Why Protection is Important	17
2.4	Outlining the Problem: Legal Issues	19
<b><u>3</u></b>	<b><u>EXISTING LEGAL FRAMEWORK</u></b>	<b><u>22</u></b>
3.1	The Issue of Standing	22
3.2	Intellectual Property Laws	26
3.2.1	Copyright	28
3.2.2	Trademark Law	34
3.3	Unfair Competition and Related Rights	41
3.3.1	Right of Publicity	42
3.3.2	Misappropriation	43
3.3.3	Quasi-Contract and Equitable Estoppel	43
3.3.4	Trade Secrets and the Duty of Confidence	44
<b><u>4</u></b>	<b><u>ADDITIONAL SOLUTIONS: WIPO AND DIGITAL DOCUMENTATION</u></b>	<b><u>47</u></b>
4.1	Advantages of Digital Documentation	47
4.2	Potential Challenges and Implications for the Future	49

<b><u>5</u></b>	<b><u>CONCLUSION</u></b>	<b><u>50</u></b>
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<b><u>REFERENCES</u></b>	<b><u>52</u></b>
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## 1 Introduction

Intellectual property law has evolved significantly from granting protection solely to physical humanly readable works, to granting protection for piano rolls, photographs, and eventually even to protecting computer programs as literary works. Such terms of art as a “copy” and “fixation” for purposes of copyright have been stretched beyond anything that was perhaps imagined at the time these terms were first used in copyright law. The temporary storage of a work on one’s computer is now considered a “copy.” A video game, the audio-visual representation of which changes based on the identity of each user, has been held to be “fixed” in a tangible medium of expression. Without a doubt, technological advances have influenced intellectual property laws to a great extent, proving that where there is a will (to get intellectual property protection) there is a way (to grant it). Profitable entities such as music production companies, pharmaceutical corporations, as well as the multitude of companies that have registered their logos as corporate trademarks undoubtedly constitute powerful lobby groups that continue to influence the evolvement of intellectual property laws.<sup>1</sup> But perhaps in our race to develop new technologies and then patent, copyright, and trademark them, we had forgotten something. Something without a powerful lobby group, but something which has served as an inspiration for a number of currently protected intellectual property works: the intangible cultural heritage of the indigenous people.

Until recently, intangible cultural heritage of the indigenous people was not something that has been frequently contemplated by legislators, courts, or international law makers. Although at first glance intellectual property law may seem like a logical means of protection for intangible cultural heritage, numerous indigenous works which are passed on from generation to generation and have no discernable author may not qualify for such protection. As a consequence, this resulted in exploitation of

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<sup>1</sup> Lorie Graham & Stephen McJohn, *Indigenous Peoples and Intellectual Property*, 19 WASH. U. J.L. & POL’Y 313 (2005).

indigenous knowledge and art by third parties without any retribution—or attribution—to the indigenous communities. Recently, efforts by international organizations such as UNESCO and WIPO have brought this issue to the forefront. Scholarship has emerged arguing for an array of solutions, including developing new international treaties, proposing *sui generis* legal protection, or using non-IPR existing means of protection. This thesis examines several existing means of legal protection for intangible cultural heritage, including intellectual property law, unfair competition law and digital rights management. It argues that, firstly, intellectual property law can be effectively applied to grant protection to some forms of intangible cultural heritage. Secondly, for those types of indigenous works where intellectual property proves inadequate, for example when indigenous legends—too old to qualify for copyright protection—are appropriated by book authors, unfair competition law may be used to fill the gaps. Finally, this thesis looks at digital recording and digital rights management of intangible cultural heritage through the use of which further legal remedies may be possible.

This thesis is organized as follows. Part 2 defines intangible cultural heritage and discusses specific instances of exploitation of intangible cultural heritage of indigenous people, including exploitation of music, imagery, and identity. Part 2 then discusses the reasons why intangible cultural heritage should be protected and explores legal issues that are unique to intangible cultural heritage. Such issues include the issue of communal right ownership common to much of indigenous intangible cultural heritage which, when juxtaposed with individual nature of rights in Western legal thought, may be difficult to apply in courts. Part 3 discusses currently existing legal protection which can be applied to intangible cultural heritage, including intellectual property and unfair competition laws. Part 3 illustrates such application by discussing several court cases. Part 4 discusses recent efforts made by WIPO to encourage digital documentation of intangible cultural heritage as additional means to supplement some of the inadequacies of intellectual property protection of intangible cultural heritage. Part 5 concludes this thesis, arguing that intellectual property laws combined with unfair competition, equity and digital documentation when used together may provide adequate means of protection of intangible cultural heritage.

## 2 Issues in Exploitation of Indigenous Intangible Cultural Heritage

### 2.1 Definitions

The definition of cultural heritage has varied throughout the years.<sup>2</sup> Cultural heritage can refer to a variety of things, for example the historical heritage of a country such as an architectural site or geographical areas in need of conservation.<sup>3</sup> It may also refer to religious relics of sub-cultures within a country, such as those of the indigenous people. The term encompasses all of these things and has been summed up by UNESCO as “entire spirit of a people in terms of its values, actions, works, institutions, monuments and sites.”<sup>4</sup>

Cultural heritage can be divided into two categories: tangible and intangible. Tangible cultural heritage generally refers to physical objects or property of historical, aesthetic or anthropological significance, such as artifacts or architecture.<sup>5</sup> Legal issues with respect to tangible cultural heritage generally arise in the context of illegal trafficking of the property, or at times of armed conflict when physical objects of cultural significance are either destroyed or looted. Tangible cultural heritage is also relevant with respect to preservation and safeguarding of items found in museums.<sup>6</sup> The international discourse in the context of cultural heritage has mainly focused on its tangible aspects. Today, as

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<sup>2</sup> See UNESCO, Cultural Heritage, [http://portal.unesco.org/culture/en/ev.php-URL\\_ID=2185&URL\\_DO=DO\\_TOPIC&URL\\_SECTION=201.html](http://portal.unesco.org/culture/en/ev.php-URL_ID=2185&URL_DO=DO_TOPIC&URL_SECTION=201.html) (last visited Mar. 25, 2010).

<sup>3</sup> Erin K. Slattery, *Preserving the United States' Intangible Cultural Heritage: an Evaluation of the 2003 UNESCO Convention for the Safeguarding of the Intangible Cultural Heritage as a Means to Overcome the Problems Posed by Intellectual Property Law*, 16 DEPAUL-LCA J. ART & ENT. L. 201 (2006) (defining “natural cultural heritage” as a type of cultural heritage in general).

<sup>4</sup> UNESCO, Cultural Heritage Sites, available at [http://portal.unesco.org/culture/en/ev.php-URL\\_ID=1535&URL\\_DO=DO\\_TOPIC&URL\\_SECTION=201.html](http://portal.unesco.org/culture/en/ev.php-URL_ID=1535&URL_DO=DO_TOPIC&URL_SECTION=201.html) (last visited Mar. 28, 2010); see also Slattery, *supra* note 3, at 204.

<sup>5</sup> Slattery, *supra* note 3, at 206.

<sup>6</sup> UNESCO, Movable Heritage and Museums, available at [http://portal.unesco.org/culture/en/ev.php-URL\\_ID=34324&URL\\_DO=DO\\_TOPIC&URL\\_SECTION=201.html](http://portal.unesco.org/culture/en/ev.php-URL_ID=34324&URL_DO=DO_TOPIC&URL_SECTION=201.html) (last visited Mar. 28, 2010).

a result of this discourse, tangible cultural heritage is protected under international treaties and conventions.<sup>7</sup>

The focus of this thesis, however, is on *intangible* cultural heritage, the definition of which has also varied. UNESCO defines intangible cultural heritage as

the practices, representations, expressions, knowledge, skills—as well as the instruments, objects, artifacts and cultural spaces associated therewith—that communities, groups and, in some cases, individuals recognize as part of their cultural heritage. This intangible cultural heritage, transmitted from generation to generation, is constantly recreated by communities and groups in response to their environment, their interaction with nature and their history, and provides them with a sense of identity and continuity, thus promoting respect for cultural diversity and human creativity.<sup>8</sup>

However, this is but one definition. Intangible cultural heritage has also been defined as “performances such as dance, song and story as well as knowledge systems—the diverse ways in which people understand the world around them, their language, cosmology and spiritual beliefs, even traditional systems of healings.”<sup>9</sup> Others have used the term “cultural intellectual property” instead of “intangible cultural heritage,” to refer to the cultural works that might fall under the traditional rubric of intellectual property laws.<sup>10</sup> Indeed, the two terms have largely the same meaning as the term “intangible” is generally referred to non-physical or incorporeal and “when applied to property, would include intellectual property.”<sup>11</sup> In sum, the term intangible cultural heritage refers to artistic expressions, knowledge and traditions of various cultures.

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<sup>7</sup> See, e.g., The Hague Convention for the Protection of Cultural Property in the Event of Armed Conflict 1954, available at <http://unesdoc.unesco.org/images/0008/000824/082464mb.pdf>; UNESCO Convention on the Means of Prohibiting and Preventing the Illicit Import, Export and Transfer of Ownership of Cultural Property (Nov. 14 1970), available at <http://unesdoc.unesco.org/images/0011/001140/114046e.pdf#page=130>.

<sup>8</sup> UNESCO, Convention for the Safeguarding of Intangible Cultural Heritage Art.2 (Oct. 17, 2003) available at <http://unesdoc.unesco.org/images/0013/001325/132540e.pdf>.

<sup>9</sup> Anita Smith, Protecting Intangible Heritage: Anita Smith Defines Intangible Heritage, 1 (2002) available at <http://home.vicnet.net.au/~museaust/insite/anita%20smith.pdf>, see also Slattery, supra note 3, at 207.

<sup>10</sup> Sarah La Voi, *Cultural Heritage Tug of War: Balancing Preservation Interests and Commercial Rights*, 53 DEPAUL L. REV. 875 (2003).

<sup>11</sup> Daniel J. Gervais, *Spiritual But Not Intellectual? The Protection of Sacred Intangible Traditional Knowledge*, 11 CARDOZO J. INT’L & COMP. L. 467 (2003).

The scope of this thesis, however, is confined to intangible cultural heritage of indigenous people. No one formal definition of “indigenous” exists within the international community, although there have been several efforts in defining the term in international documents.<sup>12</sup> The United Nations Development Group Guidelines on Indigenous Peoples’ Issues overview of how international instruments define the term “indigenous” is informative. According to the Guidelines, the term “indigenous” is referred to the people who have a temporal priority of occupation of the territory of a nation currently established on that territory, who consider themselves culturally, ethnically and economically distinct from that nation’s main society and who currently form a non-dominant part of that society and follow their own customs, traditions, or legal systems.<sup>13</sup> Generally, self-identity of a person as indigenous is the most important criterion in determining this classification.<sup>14</sup>

The term “indigenous” as used in this thesis is largely in conformity with the definitions laid out by the UN Development Group’s Guidelines mentioned above. In addition, for purposes of this thesis, the phrase intangible cultural heritage will refer to those aspects of indigenous people’s culture that would fall under intellectual property classification, including artistic works such as music and paintings, and fictional works such as myths and folklore. Further, topics such as rights to a name and designs traditionally associated with particular indigenous communities will also be discussed under the general umbrella of intangible cultural heritage.

## 2.2 Outlining the Problem: Exploitation

Developments in technology made it particularly easy and inexpensive to copy intellectual property. Indigenous designs and art have become increasingly popular among the mainstream culture. For example, in *Milpururru* case discussed *infra*, the

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<sup>12</sup> United Nations’ Development Group Guidelines on Indigenous Peoples’ Issues at 8 (Feb. 2008), available at <http://www2.ohchr.org/english/issues/indigenous/docs/guidelines.pdf>

<sup>13</sup> *Id.* at 8-9, citing ILO’s Indigenous and Tribal Peoples Convention, 1989 (No. 169), Study of the problem of discrimination against indigenous populations (E/CN.4/Sub.2/1986/7), and Working paper on the concept of “indigenous people” of the Working Group on Indigenous Populations (E/CN.4/Sub.2/AC.4/1996/2).

<sup>14</sup> *Id.* at 9.



alleged infringer first tested the market with several designs before finally settling with an indigenous design based on Aboriginal artwork which he determined had the greatest market demand. As a result of this demand, marketers see indigenous art and design simply as another business opportunity, to be commodified and exploited with no compensation or credit to the source. Below are several illustrative examples of commercial exploitation of indigenous artwork, music, and legends, as well as of a use trademark disparaging to the indigenous people.<sup>15</sup>

## 2.2.1 Two Cases of Infringement of Aboriginal Art in Australia

### 2.2.1.1 The Case of Legends on Textiles: *Bulun Bulun v. R & T Textiles*

John Bulun Bulun, an Australian Aboriginal artist of the Ganalbingu community, has been shortchanged twice. First, unbeknownst to him, the depictions in his paintings were printed on T-shirts and then sold to tourists. He sued, and the case has been settled out of court.<sup>16</sup> Then he discovered that his work was depicted on clothing fabric that was imported and sold in Australia, without his consent. Bulun Bulun had a valid copyright ownership in his paintings under Australian law. However, Bulun Bulun's work, which has been displayed publicly and has been published in a book, depicted sacred images of the Ganalbingu people. Specifically, the designs portrayed by Bulun Bulun, and another artist involved in the case, were Ganalbingu creation legends. The designs' original maker was said to be the Aborigines' creator-ancestor, Barnda, and they have been passed on since from generation to generation.<sup>17</sup> The designs thus belonged not to Bulun Bulun, but to his people. As a result the copyright was not his alone, he argued, an argument that was ultimately accepted by the court in *Bulun Bulun v. R&T Textiles*.<sup>18</sup>

According to the court, the case represented an effort "by Aboriginal people to have communal title . . . in their artwork, recognized and protected by the Australian legal

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<sup>15</sup> These examples were chosen to illustrate the relevant legal issues that arise with respect to intangible cultural heritage, but they are not by any means exhaustive.

<sup>16</sup> *Bulun Bulun and Another v. R&T Textiles Pty Ltd*, 86 F.C.R. 244, 252 (1998).

<sup>17</sup> *Id.* at 249.

<sup>18</sup> *Id.*

system.”<sup>19</sup> The claimants in the case asserted not only a claim of infringement of their own copyright, but also a claim that the members of their entire tribe, the Ganalbingu people, are equitable owners of the copyright in the works. The claimants argued that the subject matter of their work incorporates symbols that are sacred to the Ganalbingu people and that under Aboriginal law and custom the Ganalbingu people as a whole have the right to allow the reproduction of the artistic work of the tribe.<sup>20</sup> Thus, under Aboriginal law, if an individual artist wanted to license his or her work, all of the traditional Aboriginal owners of the Ganalbingu country would have to give their consent, and an individual artist could not give such permission alone.<sup>21</sup>

After the case was filed, the defendant admitted infringement of Bulun Bulun’s copyright and consented to an order of a permanent injunction.<sup>22</sup> The issue that remained before the court was whether the tribe had an equitable interest in the copyright in the artistic work. The court ultimately held that though there is no equitable interest in the copyright in the artistic work on part of the tribe, there nevertheless exists a fiduciary relationship between the artist and the tribe. The transaction that gives rise to such a relationship is the use by the artist of ritual knowledge of the Ganalbingu people in an artistic form.<sup>23</sup> As a result of this use, the artist owes a fiduciary duty to the tribe. In particular, the court found that

equity imposes on [Bulun Bulun] obligations as a fiduciary not to exploit the artistic work in a way that is contrary to the laws and custom of the Ganalbingu people, and in the event of infringement by a third party, to take reasonable and appropriate action to restrain and remedy infringement of the copyright in the artistic work.<sup>24</sup>

The court was quick to point out that the finding of the fiduciary relationship only gives rise to the right of the Ganalbingu people to bring an action against the *fiduciary* to enforce an obligation, if a fiduciary has not done so.<sup>25</sup> They could not bring an infringement action against the third party outright. However, in the event that the

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<sup>19</sup> *Id.* at 247.

<sup>20</sup> *Id.* at 249.

<sup>21</sup> *Bulun Bulun v. R&T Textiles*, 86 F.C.R. at 252.

<sup>22</sup> *Id.* at 247.

<sup>23</sup> *Id.* at 262.

<sup>24</sup> *Id.* at 263.

<sup>25</sup> *Id.*

fiduciary refuses to bring an infringement action against the infringer, the court contemplated that an “occasion might exist for equity to impose a remedial constructive trust upon the copyright owner to strengthen the standing of the beneficiaries to bring proceedings to enforce the copyright” particularly in the case where “the copyright owner cannot be identified or found.”<sup>26</sup> The court found that in this case the aboriginal artist has taken appropriate steps to enforce the copyright, and as a result no additional remedies would be granted to the tribe.<sup>27</sup>

It is notable that in finding the existence of a fiduciary relationship, the court took into consideration the law and customs of the Ganalbingu people, stating that “Australian courts cannot treat as irrelevant the rights, interests and obligations of Aboriginal people embodied within customary law.”<sup>28</sup> However, the court did not consider this customary law as legally binding but instead considered it as part of the factual analysis of whether the fiduciary relationship exists.<sup>29</sup> It is also notable that, although dicta, the court held that the tribe might be able to nevertheless enforce the copyright in the event that the copyright owner cannot be found. Traditional copyright law only recognizes the individual rights of the legal author of that copyright. As a result, this case illustrates an expansion of authorship rights under copyright law recognizing, albeit implicitly, collective copyright ownership.

#### 2.2.1.2 The Case of the Trodden Dreams: *Milpururru and Others v. Indofurn*

George Milpururru, another leading Australian Aboriginal artist, was a plaintiff in a case which involved an infringement of his aboriginal art depicting creation and dreaming stories of his tribe. His work, in which he owned a valid copyright under Australian law, was depicted on rugs which were mass-produced in a factory Vietnam and sold in Australia.<sup>30</sup> The rugs had a notice that profits from the sale of every rug go

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<sup>26</sup> *Bulun Bulun v. R&T Textiles*, 86 F.C.R. at 264.

<sup>27</sup> *Id.* at 264-65.

<sup>28</sup> *Id.* at 248.

<sup>29</sup> *Id.* at 262.

<sup>30</sup> *Milpururru and Others v. Indofurn Pty Ltd and Others*, 54 F.C.R. 240, 248-49 (1994). *See also*, Christine Haight Farley, *Protecting Folklore of Indigenous Peoples: Is Intellectual Property the Answer?*, 30 CONN. L. REV. 1, 5 (1997).

to the Aboriginal artists in the form of royalties.<sup>31</sup> Milpurrruru received nothing, as this had happened without his consent or that of other artists involved in the case. Milpurrruru, two other artists, and the representative of the estates of five deceased artists, brought an action against the rug distributor in *Milpurrruru and Others v Indofurn*.<sup>32</sup>

According to Aboriginal law, the right to create paintings which portray traditional creation and dreaming stories is held by the traditional “custodians” of such images.<sup>33</sup> Usually this right is held by a group of people who have the authority to jointly determine whether the story and images may be used in artwork, as well as decisions with regard to reproduction and distribution of such work.<sup>34</sup> Typically permission to reproduce such work is given in order to educate the general public about Aboriginal culture, as was the case when some of these images were used with permission on Australian stamps.<sup>35</sup>

The infringer in question, Bethune, has made half-hearted attempts to obtain permission to reproduce the work in question. He purchased several rugs from a factory in Vietnam that was owned by a relative of a potential customer in an unrelated venture as a way to “sweeten” the deal with the latter.<sup>36</sup> After testing the market for these rugs in Australia, Bethune ordered more rugs with Aboriginal designs with intent to sell them.<sup>37</sup> He then drafted a letter to the Aboriginal Arts Management Association (AAMA) which gives advice to Aboriginal people with respect to copyright and has the power to bring infringement lawsuits.<sup>38</sup> In the letter he indicated the designs he used as well as the number and size of the rugs, greatly understating them, and enclosed a check for \$750 for royalties.<sup>39</sup> Although he was made aware that he should wait for the response and approval first, Bethune nevertheless proceeded with an exhibition of the rugs and

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<sup>31</sup> *Milpurrruru and Others v. Indofurn Pty Ltd and Others*, 54 F.C.R. at 281.

<sup>32</sup> *Id.*

<sup>33</sup> *Id.* at 245.

<sup>34</sup> *Id.*

<sup>35</sup> *Id.*

<sup>36</sup> *Milpurrruru v. Indofurn*, 54 F.C.R. 240, at 248.

<sup>37</sup> *Id.* at 249.

<sup>38</sup> *Id.* at 250.

<sup>39</sup> *Id.*

offering them for sale without permission.<sup>40</sup> The letter addressed to AAMA was addressed incorrectly and was never received.<sup>41</sup> AAMA was contacted by an arts dealer inquiring whether the rugs in question, some of which were on sale for as much as \$4,252, had copyright approval.<sup>42</sup> AAMA then sent a cease and desist letter to Bethune requesting cessation of manufacture and sale of the rugs, and a demand for profits.<sup>43</sup> Instead of complying, Bethune and his wife sent a letter to AAMA accusing it of not acting in the best interest of the artists by not granting the copyright license.<sup>44</sup> Bethune later also attempted to contact some of the artists directly, but was likewise refused. The case in question was then commenced. As part of his argument in the case, Bethune denied copyright ownership of the artists despite having sought their copyright permission earlier.<sup>45</sup>

The claims asserted by the artists in this case concerned only infringement of their own copyright in their works. Of particular offense to the artists was not only Bethune's offering the rugs for sale without their permission but the medium for reproduction of the work: rugs. Because the imagery depicted were from the sacred creation and dreaming stories of the Aboriginal people, having them depicted on rugs on which people would *walk* on was extremely offensive.<sup>46</sup>

However, despite the individual nature of the claims, evidence with respect to the collective ownership in the works under Aboriginal law became relevant in the court's determination of damages. In particular, the court considered the evidence that under Aboriginal law, if the tribe gave permission "to a particular artist to create a picture of the dreaming, and that artwork is later inappropriately used or reproduced by a third party the artist is held responsible . . . even if the artist had no control over or knowledge of what occurred."<sup>47</sup> The artist may be subject to punishment under Aboriginal law, which depending on severity of the offense, may include banning the

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<sup>40</sup> *Id.* at 251.

<sup>41</sup> *Milpururru v. Indofurn*, 54 F.C.R. 240, at 251.

<sup>42</sup> *Id.* at 252.

<sup>43</sup> *Id.*

<sup>44</sup> *Id.* at 253.

<sup>45</sup> *Id.* at 255-56.

<sup>46</sup> *Milpururru v. Indofurn*, 54 F.C.R. at 246.

<sup>47</sup> *Id.*

artist from participation in ceremonies or the community altogether, removal of the right to create any further artwork involving images or stories of the tribe, or financial restitution.<sup>48</sup> The court considered this, along with Bethune's behavior, as evidence for "flagrant infringement" to award additional damages in the case.<sup>49</sup> In addition, at the request of the plaintiffs, the court split the damages in the action equally among the infringed parties in accordance with Aboriginal law and custom.<sup>50</sup>

Both *Milpururru* and *Bulun Bulun* cases demonstrate willingness on the part of Australian courts to use intellectual property laws in combination with principles of equity to afford protection to indigenous intellectual property. In particular, *Bulun Bulun* constitutes an important precedent as to collective rights of indigenous people under copyright law.

### 2.2.2 The Case of Disparagement: *Pro-Football v. Harjo*

The Washington Redskins has been a name of a football team, owned by Pro-Football, since 1933.<sup>51</sup> The term "redskins" is also a derogatory term that denotes a racist label for a Native American person.<sup>52</sup> Indeed, in 1930's when the name was began to be used by the football team, Native Americans were reduced to the stereotype of "savages whose culture was treated mainly as a source of amusement for white culture" and the term "redskins" was used by the public, including newspapers, in association with violence, savagery and as a negative racial stereotype.<sup>53</sup>

A selection of a football team name typically involves something that denotes dominance, fierceness, or even violence, designed to strike fear in the eyes of the opposing teams.<sup>54</sup> Football team names include names of preying animals such as

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<sup>48</sup> *Id.* at 246.

<sup>49</sup> *Id.* at 278-281.

<sup>50</sup> *Id.* at 272. The Court stated that normally the judge would "specify separate judgment in favour of each applicant, assessed according to the loss and damage which each suffered." *Id.*

<sup>51</sup> *Pro-Football v. Harjo*, 57 U.S.P.Q.2d 1140 (2000) (Harjo III).

<sup>52</sup> *Harjo v. Pro Football Inc.* 30 U.S.P.Q.2d 1828, 1829 (1994) (Harjo I).

<sup>53</sup> *Harjo v. Pro-Football*, 50 U.S.P.Q.2d 1705, 1719-20 (Harjo II).

<sup>54</sup> *Id.* at 1720.

Lions or Jaguars, as well as team names such as Minnesota Vikings.<sup>55</sup> Because the term “redskins” was commonly used in association with savagery and violence in 1930’s, as a football name it was designed to “evoke the sense of an implacable and ferocious foe,”<sup>56</sup> which largely promoted the negative connotation of the term. Pro-Football has stated that it picked the term for its football team to honor Native Americans.<sup>57</sup>

Pro-Football then registered the name “Redskins” as a trademark with United States Patent and Trademark Office (USPTO). A number of other registrations followed, all involving the word “Redskins” either alone or in conjunction with other words. The first registration for “the Redskins” was issued by USPTO to Pro Football in 1967, and the last “Redskinettes” to be used in association with a cheerleading team was issued in 1990.<sup>58</sup> A group of Native Americans, who were members of several federally recognized Native American tribes, filed a petition for cancellation of these marks with the USPTO in 1992 on the ground that they were disparaging.<sup>59</sup> The case has been litigated since that time for over a decade, resulting in numerous appeals and remands, finally culminating with the U.S. Supreme Court’s denial of writ of certiorari in 2009.<sup>60</sup> The ultimate result of this extended litigation was that the petition for cancellation of these disparaging marks was denied.

The issue upon which the case turned involved an equitable estoppel doctrine. At common law, equity is applied by courts to rectify what is a wrong, but which does not have direct remedy at law. As a result, in a number of cases involving indigenous people, equity is often used to fill the gaps in the law where law itself fails to protect them. It is perhaps ironic that the doctrine of equitable estoppel was used *against* the Native Americans in this case, and in the end was what defeated their cause of action. Specifically, the case was defeated based on the doctrine of laches.

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<sup>55</sup> National Football League Team Names, <http://www.nfl.com/teams>.

<sup>56</sup> Harjo II, 50 U.S.P.Q.2d at 1720.

<sup>57</sup> Harjo III, 57 U.S.P.Q.2d at 1140.

<sup>58</sup> Harjo I, 30 U.S.P.Q.2d at 1829.

<sup>59</sup> *Id.* at 1829.

<sup>60</sup> Harjo v. Pro-Football, Inc., 130 S.Ct. 631 (2009).

The respondents in this litigation raised numerous affirmative defenses to the petition for cancellation, including laches.<sup>61</sup> Laches is an equitable defense similar to a statute of limitations; the respondents in this case argued that petitioners had simply run out of time in which they could bring the cancellation. “The doctrine of laches bars relief to those who delay the assertion of their claims for an unreasonable time. Laches is founded on the notion that equity aids the vigilant and not those who slumber on their rights.”<sup>62</sup> Unlike the statute of limitations—which states a specific time period in which a case may be brought in the relevant statute—laches has no specific time limitation. Whether or not a claim is barred by laches is determined by the court on a case by case basis, based on its consideration of all the facts in each particular case.<sup>63</sup>

The petitioner’s cancellation petition was based on Section 2(a) of the Lanham Act, barring the registration of marks that are immoral, scandalous or disparaging,<sup>64</sup> and Section 14(3) of the Lanham Act, which states that a petition to cancel a registration of a mark may be filed “*at any time*” if the registration to the mark was obtained contrary to the provisions of section 2(a), among others.<sup>65</sup> When the petition for cancellation was first filed, the USPTO’s Trademark Trial and Appeal Board (TTAB), petitioners moved to strike the laches defense asserted by the respondents. They argued that “the plain language of Section 14(3) of the Trademark Act—language that allows cancellation of registrations ‘at any time’ . . . precludes the application of the laches” defense.<sup>66</sup> The TTAB held for the petitioners, striking the defense of laches, under the public policy interest to prevent a registrant from benefiting from a mark that holds “a substantial segment of the population to public ridicule.”<sup>67</sup>

Respondents appealed the case to federal district court for a *de novo* review.<sup>68</sup> The district court overturned TTAB’s decision holding that the petition was barred by

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<sup>61</sup> Harjo I, 30 U.S.P.Q.2d at 1829-30.

<sup>62</sup> NAACP v. NAACP Legal Defense & Educational Fund, Inc. 753 F.2d 131, 137 (D.C.Cir. 1985).

<sup>63</sup> Pro-Football, Inc. v. Harjo, 284 F.Supp.2d 96, 138 (D.D.C. 2003) (Harjo IV). (stating that “as appropriate in all laches cases, the Court’s holding is specific to the facts and circumstances of this case.”).

<sup>64</sup> 15 U.S.C. §1052(a) (Lanham Act §2(a)).

<sup>65</sup> 15 U.S.C. §1064(3) (emphasis added).

<sup>66</sup> Harjo I, 20 U.S.P.Q.2d at 1830-31.

<sup>67</sup> *Id.* at 1831.

<sup>68</sup> Harjo IV, 284 F.Supp.2d at 96.



laches, however qualifying its decision by stating that it “should not be read as making any statement on the appropriateness of Native American imagery for team names.”<sup>69</sup> Native Americans appealed. The Court of Appeals remanded the case back to the District Court on the ground that one petitioner, Romero, was only one year old at the time the first mark was registered in 1967, holding that laches would only run against that petitioner after he had reached the age of majority.<sup>70</sup> Upon remand, the District Court held that laches has barred even Romero’s action due to its seven-year and nine-month delay, but reiterating again that “this opinion should not be read as making any statement on the appropriateness of Native American imagery for team names.”<sup>71</sup> After this judgment the case was appealed again to the Court of Appeals, which upheld the District Court’s decision.<sup>72</sup> A petition for a writ of certiorari was then made to the U.S. Supreme Court, which was denied.<sup>73</sup> Because the petition for cancellation of the mark was thus denied, the Washington Redskins continue to use the mark in association with their football team today.

### 2.2.3 Something of an Enigma: the Case of Lifvon Guo

It came as a surprise when Lifvon Guo, a farmer and a member of the Taiwanese Ami Tribe who also sang traditional chants, received a telephone call from his friend who stated “your voice is on the radio.”<sup>74</sup> It came as a surprise because to his knowledge his voice—which has been described as deep and melodic<sup>75</sup>—has never been recorded. After some investigation it turned out it had been, albeit without Lifvon Guo’s permission. Some years prior to the phone call, the French ministry had invited Lifvon Guo and other members of his tribe for a tour, to perform their chants in various cities across Europe.<sup>76</sup> The group earned \$15 for each performance.<sup>77</sup> During one of their

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<sup>69</sup> *Id.* at 144-45.

<sup>70</sup> *Pro-Football, Inc. v. Harjo*, 415 F.3d 44, 48-50 (D.C. Cir. 2005) (Harjo V).

<sup>71</sup> *Pro-Football, Inc. v. Harjo*, 567 F.Supp.2d 46, 62 (2008) (Harjo VI).

<sup>72</sup> *Pro-Football v. Harjo*, 565 F.3d 880 (2009) (Harjo VII).

<sup>73</sup> *Harjo v. Pro-Football, Inc.* 130 S.Ct. 631 (2009).

<sup>74</sup> Renata Huang, *Golden Oldies: A Respected Amis Tribe Elder Seeks Recognition for His Chart-Topping Chants.*, FAR EASTERN ECONOMIC REVIEW, Nov. 2, 1995.

<sup>75</sup> *Id.*

<sup>76</sup> *Id.*

<sup>77</sup> *Id.*

performances, the French ministry recorded them and put together an album. This CD was later heard by Michael Cretu, the creator of the German music group “Enigma.”<sup>78</sup> Lifvon Guo’s chant was just the thing that Cretu was looking for his new album, and he paid to the French ministry for the rights to use the song,<sup>79</sup> a right that wasn’t the ministry’s to sell. Needless to say, Lifvon Guo had no knowledge of the initial recording by the French, nor of the subsequent sale of the rights to use that recording.

Cretu combined the recorded chant with a modern beat to create a song called “Return to Innocence” released on Enigma’s album “Cross of Changes.”<sup>80</sup> The album, five million copies of which were sold, topped the music charts for over thirty-two weeks.<sup>81</sup> Lifvon Guo received neither credit nor remuneration. Indeed, according to the director of Taiwan’s Association of Recording Copyright Owners, he was entitled to neither. “The original authors of traditional folk chants have long been dead. And since performers are not authors, they have no copyrights,” he was quoted as saying, to which Lifvon Guo was quoted as saying “that’s crazy.”<sup>82</sup>

There was no court litigation in this case and as a result no legal remedy for Lifvon Guo. This case demonstrates some of the legal complexities faced by the indigenous people when their intellectual property has been infringed. First, there is the problem of copyrightability *per se*: for example the lack of fixation of the performance—a requirement for copyright protection in some jurisdictions, including the United States—in addition to lack of authorship and originality. Second, there is the issue of which forum should try the case, which is dependent on both the jurisdiction of the court along with the more practical issue of the ability of the tribe member himself, whose resources are very limited, to initiate litigation in a jurisdiction other than Taiwan. Third, as is the case with any cross-border dispute, there is the issue of applicable law which may ultimately determine the outcome of the case itself. Finally, unlike the artists in the two Australian cases who were fully aware of their legal rights, Lifvon Guo was largely ignorant of legal remedies, if any, that might have been

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<sup>78</sup> *Id.*

<sup>79</sup> Huang, *supra* note 74.

<sup>80</sup> *Id.*

<sup>81</sup> *Id.*

<sup>82</sup> *Id.*

available to him. “I’m a country bumpkin” he said, “I know nothing about the legal process, but I know that I’ve been wronged.”<sup>83</sup>

#### 2.2.4 The Right to One’s Name and Image: the Twilight Saga

The Quileutes, also known as Quillayutes, are a Native American tribe situated on a reservation near Washington State’s Olympic Peninsula.<sup>84</sup> Most of the tribe members live in the reservation town of La Push.<sup>85</sup> According to the Quileute folklore, the tribe had been created from the wolves.<sup>86</sup> Stephenie Meyer is a novelist who penned the four-volume “Twilight Saga” about Bella, a young woman who fell in love with Edward, a vampire, and Jacob, a Native American who can turn into a wolf and is the vampire’s only mortal enemy. Jacob is a member of the Quileute tribe and lives in La Push. He reveals a legend of his tribe to Bella, a legend he’s “not supposed” to tell.<sup>87</sup> He tells her of a legend which “claims that we descended from wolves—and that the wolves are our brothers still. It’s against tribal law to kill them.”<sup>88</sup>

The Twilight Saga books became international best sellers, generating an enormous amount of revenue. According to some estimates, the combined revenue from book sales, movie ticket and DVD sales, and profits from associated merchandise exceed one billion dollars.<sup>89</sup> Some of the merchandise depicts the Quileute name and associated imagery. Some have raised concern that there is capitalization on Quileute name and images, without Quileutes’ consent or financial compensation, compensation they would welcome as “half of Quileute families still live in poverty.”<sup>90</sup> However just recently, the Quileute tribe announced the opening of an e-commerce website that sells authentic Quileute merchandise which is “hand crafted by Quileute artisans and features

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<sup>83</sup> *Id.*

<sup>84</sup> ROBERT H. RUBY & JOHN ARTHUR BROWN, A GUIDE TO THE INDIAN TRIBES OF THE PACIFIC NORTHWEST, 171 (Revised Ed. 1992).

<sup>85</sup> *Id.*

<sup>86</sup> *Id.*

<sup>87</sup> STEPHENIE MEYER, TWILIGHT, 106 (Atom, 2007).

<sup>88</sup> *Id.* at 107.

<sup>89</sup> Angela R. Riley, *Sucking the Quileute Dry*, *Op-Ed*, NY TIMES, Feb 7, 2010, available at <http://www.nytimes.com/2010/02/08/opinion/08riley.html>.

<sup>90</sup> *Id.*

carved cedar wolf rattles and paddles; woven cedar baskets and hats; canned smoked Salmon from First Beach; ‘Twilight’ inspired handmade items like ‘Jacob’ . . . wool hats; wolf dream catchers and other delights.”<sup>91</sup>

This example demonstrates that cultural exploitation does not always occur to the detriment of indigenous people. The tribe in question was able to successfully embrace the popularity of its name and image as a result of the success of the Twilight Saga, and use it to its financial advantage. In addition, had there been an attempt to trademark the Quileute name,<sup>92</sup> Quileutes would likely benefit from the USPTO policy to deny registration of Native American tribal insignia to individuals having no association with the tribe.<sup>93</sup> But this success may be considered bitter-sweet. The Quileutes would not have been able to reap the profits from selling the merchandise depicting the name of their tribe along with traditional tribal imagery without Twilight. But Stephenie Meyer’s Twilight Saga, which earned her much more than Quileutes could ever earn from selling the merchandise, incorporated Quileute folklore as part of its story and as a result the success of her books may not have been as great without it.

### 2.3 Outlining the Problem: Why Protection is Important

Protection of intangible cultural heritage is important from a cultural and a historical standpoint. Intangible cultural heritage of the indigenous people contributes to cultural diversity of the world.<sup>94</sup> Indeed, it is especially significant in terms of the very preservation of indigenous culture, as viewed by the indigenous peoples themselves. “Indigenous peoples cannot survive, or exercise their fundamental human rights as distinct nations, societies and peoples, without the ability to conserve, revive, develop

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<sup>91</sup> Examiner.com, Quileute Nation Opens “Twilight” Website, Authentic Merchandise Store, Mar. 29, 2010, available at <http://www.examiner.com/x-4908-Twilight-Examiner~y2010m3d29-Quileute-Nation-opens-Twilight-website-authentic-merchandise-store>. For the e-commerce store, see [www.Quileute-Store.com](http://www.Quileute-Store.com).

<sup>92</sup> A search of the USPTO Trademark Electronic Search System (TESS) revealed no current or pending registrations associated with the name “Quileute.” See <http://www.uspto.gov/ebc/tess/index.html> (last visited Mar. 29, 2010).

<sup>93</sup> See *infra*, Part 3.2.2.1.

<sup>94</sup> UNESCO, Convention for the Safeguarding of the Intangible Cultural Heritage, Oct. 17, 2003, available at <http://unesdoc.unesco.org/images/0013/001325/132540e.pdf>.

and teach the wisdom they have inherited from their ancestors.”<sup>95</sup> The erosion of intangible cultural heritage as a result of infringement then threatens to undermine the very foundation of indigenous culture. Every time it is stolen by the outsiders for financial gain “the heritage itself dies a little, and with it its people.”<sup>96</sup>

Protection of intangible cultural heritage is also particularly important in the new digital age. Technological advancements and innovation have made copying easy and inexpensive. New technological developments such as digital recording devices to record music or cameras to snap pictures of an artwork make reproduction of potentially infringing material a rather effortless endeavor. The Internet provides an easy platform for dissemination of such material. This ease of copying and distribution, combined with the growing demand for indigenous art, as demonstrated by the *Millpurrruru* case, makes commodification of indigenous culture by the outsiders especially tempting. As a result, protection of indigenous cultural heritage under the law today is especially relevant.

Safeguarding intangible cultural heritage is also significant in terms of ensuring financial independence of indigenous people. One specific example of theft of cultural heritage makes a strong case for the need for its legal protection, which is when an indigenous group sells its art or craftwork to the public. As *Milpurrruru* case showed, the infringer in question was able to use the labor of Vietnamese rug weavers for relatively low cost<sup>97</sup> to manufacture the rugs and then sell the rugs in Australia for significant profit. However the Australian aboriginal artists whose artworks he copied did not make rugs themselves, in fact they found the very fact of the imagery being portrayed on a rug people walked on offensive. But in a case where an infringer copies art or craft of the indigenous people that indigenous people themselves sell for income, the infringer’s action can be particularly detrimental: it can not only undercut the indigenous market but deprive the indigenous people of a significant source of livelihood.

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<sup>95</sup> Haight Farley, *supra* note 30, at 12 (internal citations omitted).

<sup>96</sup> *Id.*

<sup>97</sup> In the case, the Vietnamese “factory” simply received the orders for the rugs, then distributing those orders among the local rug weavers who weaved them by hand. *Millpurrruru v. Indofurn*, 54 FCR at 248.

For example, women of the Kunas, an indigenous group in Panama, are famous for making molas, which are patterned rectangular panels of fabric that are used as front and back panels of blouses worn by the Kuna women.<sup>98</sup> The molas are hand-sewn and take many hours to make.<sup>99</sup> The Kuna women disassemble the blouses once they are no longer using them and sell the molas to tourists or collectors, who can then use them as either framed art, as part of a pillow case or a quilt, or other decorative uses.<sup>100</sup> “The mola blouse is an important symbol of Kuna culture and the Kuna’s main source of income.”<sup>101</sup> However during the 1980’s, as the demand for molas increased among the general public, there was a mass of importations of imitation molas by merchants.<sup>102</sup> Because the molas were one of the main sources of income for the Kunas, this wave of cheap imported molas had the potential of putting the Kunas at a significant financial disadvantage, prompting government action.<sup>103</sup>

## 2.4 Outlining the Problem: Legal Issues

Some have raised arguments that current law is insufficient and unfit to deal with unique problems posed by infringement of cultural artistic works of the indigenous people.<sup>104</sup> Indeed, some cases where there was successful application of intellectual property law resulting in a victory for indigenous people, such as the *Milpurrurru* case above, have been labeled as an “example of judicial creativity” which may not resolve the actual problem.<sup>105</sup> In many respects, it is true that intangible cultural heritage poses some challenges to the current intellectual property rights systems around the world, but it does not mean these challenges may not be overcome.

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<sup>98</sup> Irma De Obaldia, *Western Intellectual Property and Indigenous Cultures: The Case of the Panamanian Indigenous Intellectual Property Law*, 23 B.U. INT’L L.J. 337, 357 (2005).

<sup>99</sup> Molas from Panama, About Molas, <http://www.panart.com/molainfo.htm> (last visited Apr. 25, 2010).

<sup>100</sup> *Id.*

<sup>101</sup> De Obaldia, *supra* note 98, at 358.

<sup>102</sup> *Id.* at 359

<sup>103</sup> *Id.*

<sup>104</sup> See, e.g. Angela R. Riley, “Straight Stealing:” *Towards an Indigenous System of Cultural Property Protection*, 80 WASH L. REV. 69 (2005), arguing that tribal law must play a foundational role to protect cultural property of indigenous groups. See also Slattery, *supra* note 3, at 231, discussing inadequacies of copyright law to protect intangible cultural heritage.

<sup>105</sup> Haight Farley, *supra* note 30, at 7.

One of the biggest challenges posed by indigenous intellectual property, particularly with regard to copyright law, is the communal nature of legal “ownership” under indigenous customary law. In particular, indigenous intellectual property such as folklore, dance, music and art is passed on from generation to generation, with no discernable original creator or one that is long dead. Under Western legal regimes, on the other hand, legal rights are individual. And as was exemplified by *Bulun Bulun* and *Milpurrruru* cases above, even though the artists that brought the claim had individual copyright in their work, under Aboriginal custom, that right was not absolute. The right to grant permission for use of the works remained with the tribe under Aboriginal custom. This communal nature of ownership poses challenges for indigenous people to enforce their rights in courts, for example in terms of having proper standing.<sup>106</sup>

Indigenous art such as music, songs and dance are rarely recorded—at least by the indigenous people themselves—presenting an additional legal hurdle in jurisdictions that require fixation of a copyrightable work in a tangible medium, such as the United States. Indeed, a number of “indigenous oral traditions have been transplanted and published in printed form by non-indigenous authors who then themselves receive the benefits of copyright protection.”<sup>107</sup> There may be issues with respect to originality of the works. Finally, certain types of intellectual property rights, including copyright and patent law provide protection only for a limited amount of time before the work becomes part of the public domain. Even if copyright is granted to an artist for the duration of the artist’s life plus seventy years thereafter, given that some cultures date back thousands of years, this amount of time may be so small to render the protection meaningless for the indigenous people.

As a result of some of these inadequacies there has been discussion of creation of new law to cover the problem of lack of legal protection of indigenous intangible cultural heritage. Some of this discussion focuses on what has been termed “sui generis” protection of intangible cultural heritage—namely, a quasi-copyright protection that

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<sup>106</sup> See *infra*, Part 3.1.

<sup>107</sup> Robert K. Paterson & Dennis S. Karjala, *Looking Beyond Intellectual Property in Resolving Protection of the Intangible Cultural Heritage of Indigenous Peoples*, 11 CARDOZO J. INT’L & COMP. L. 633, 639 (2003).

would grant protection unlimited in time for indigenous people who would be able to assert group, instead of individual, rights.<sup>108</sup>

However, before a conclusion may be drawn that current legal protection for most types of intangible cultural property is inadequate, an account must also be taken of *all* the tools that are currently available with respect to intangible cultural property protection—including not only intellectual property and related doctrines such as unfair competition, but also digital documentation and digital rights management system. Though intellectual property law is not perfect, as no legal regime is, the next section will show that it can be applied effectively to protect certain types of intangible cultural heritage. Indeed, the law is not static; it is constantly evolving and fluid to be able to cover unprecedented cases that frequently arise. But where intellectual property fails to protect intangible cultural heritage, other legal doctrines, including that of unfair competition may be applied. In addition, digital documentation and digital rights management systems may be used for other types of indigenous culture such as music and dance to enable indigenous people manage their intellectual property rights effectively.

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<sup>108</sup> See, e.g. De Obaldia, *supra* note 98 (discussing sui generis law currently in existence in Panama); see also Gervais, *supra* note 11, (discussing collective intellectual property system).



### 3 Existing Legal Framework

This section explores possible avenues of legal protection for intangible cultural heritage with a focus on intellectual property, unfair competition and other equitable doctrines. This section ultimately argues that intellectual property law and related rights can be applied effectively to cases of infringement of intangible cultural heritage. These legal tools can also be used in conjunction with digital documentation of indigenous intangible heritage, an effort that is being developed by WIPO's Creative Heritage Project, which is discussed in Part 4. The first section of Part 3 discusses the issues of standing that may be faced by indigenous communities in trying to bring a legal case, the second section discusses intellectual property laws including copyright and trademark law, the third and final section focuses on unfair competition and equity including the right of publicity, misappropriation, quasi-contracts, and trade secrets.

#### 3.1 The Issue of Standing

A legal right to something implies the ability to enforce it, otherwise the right is rendered meaningless.<sup>109</sup> An individual or a group of individuals typically enforce their rights in the court of law. Under common law, in order to be able to bring an action in court one must have standing. Throughout scholarship written on the topic of legal protection of intangible cultural heritage the issue is often ignored, or is addressed peripherally, by means of for example describing the problem of ascertaining the “author” of the work in question for purposes of copyright. But the issue of standing is crucial to one's ability to bring an action in court—without standing in the first place, a case cannot be heard.<sup>110</sup>

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<sup>109</sup> Daniel Austin Green, *Indigenous Intellect: Problems of Calling Knowledge Property and Assigning it Rights*, 15 TEX. WESLEYAN L.R. 335 (2009), available at <http://ssrn.com/abstract=1410147>, stating that a right becomes meaningful once it vests and one may enforce it.

<sup>110</sup> 35A C.J.S. Federal Civil Procedure § 59 (2009).

Standing is in essence the question of “whether the litigant is entitled to have the court decide the merits of the dispute or of particular issues.” The courts evaluate the question of standing at the outset of the litigation, and its assessment—similarly to other issues of civil procedure such as jurisdiction and venue—is wholly independent of the actual merits of the case. Under U.S. federal law there are two elements to standing: constitutional and prudential.<sup>111</sup> The requirements of both must be satisfied before a case may be heard in a federal court.<sup>112</sup>

The concept of constitutional standing arises from Article III of the U.S. Constitution, which gives the federal courts the power to hear justiciable cases and controversies.<sup>113</sup> Under the concept of constitutional standing, a plaintiff bringing a case in court must satisfy three prongs: an injury in fact, a causal link between that injury and the defendant’s conduct, and the ability of the court to redress that injury in a favorable way.<sup>114</sup> The concept of prudential standing is a judicially created doctrine.<sup>115</sup> Under the element of prudential standing, a plaintiff must again satisfy three prongs. First, the plaintiff must be the aggrieved party—that is, a third party generally may not bring a lawsuit on behalf of someone else.<sup>116</sup> Second, it must be proved that the claim is not a general one—that the harm suffered is suffered by the plaintiff and is not a general grievance that is shared by a large class of people.<sup>117</sup> Third, the injury must fall within the zone of interest that a statute asserted in the claim is intended to remedy.<sup>118</sup>

Federal rules of standing do not apply to state courts.<sup>119</sup> Nor do they apply to administrative proceedings before an administrative agency or board, such as the USPTO.<sup>120</sup> Cases that may be brought before USPTO include opposition proceedings to for example marks that one deems immoral or scandalous under Section 2(a) of the

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<sup>111</sup> *Warth v. Seldin*, 422 U.S. 490, 498 (1975) stating that the inquiry of standing “involves both constitutional limitations on federal-court jurisdiction and prudential limitations on its exercise.”

<sup>112</sup> 35A C.J.S. Federal Civil Procedure §§ 59-61 (2009).

<sup>113</sup> *Allen v. Wright*, 468 U.S. 737, 750 (1984), *Lujan v. Defenders of Wildlife*, 504 U.S. 555, 560 (1992).

<sup>114</sup> *Lujan*, 504 U.S. at 560-61.

<sup>115</sup> 35A C.J.S. Federal Civil Procedure § 61 (2009).

<sup>116</sup> *Warth v. Seldin*, 422 U.S. at 499, *Allen v. Wright* 468 U.S. at 751.

<sup>117</sup> *Warth v. Seldin*, 422 U.S. at 499.

<sup>118</sup> *Allen v. Wright* 468 U.S. at 751.

<sup>119</sup> 1A C.J.S. Actions § 103 (2009).

<sup>120</sup> *Ritchie v. Simpson*, 170 F.3d 1092, 1093 (Fed. Cir. 1999).

Lanham Act.<sup>121</sup> Opposition proceedings to marks that are immoral or scandalous are relevant to this discussion insofar as the registration of marks by third parties that are offensive to indigenous people is concerned, as was the case in *Harjo v. Pro-football*.<sup>122</sup> In such cases issue of standing may still arise, grounded in the relevant statute that confers standing before an administrative agency, such as the Lanham Act. In order to have standing before USPTO, a person must meet the statutory requirement of a belief that he or she would suffer damage upon the registration of the mark,<sup>123</sup> and two judicially created requirements of real interest and a reasonable basis for the belief of damage.<sup>124</sup> The real interest requirement is similar to the federal requirement of having a personal stake in the case—a claimant must demonstrate a “direct injury to himself.”<sup>125</sup> The reasonable belief of damage may either be found if the person challenging the mark possesses “a trait or characteristic that is clearly and directly implicated in the proposed mark” or by showing that “others also share the same belief of harm” which may be shown by evidence of surveys.<sup>126</sup>

The issue of standing is crucial to the enforceability of legal rights of indigenous people because of the uncertainty with regards to whom the right to be enforced belongs. As mentioned, many indigenous peoples have a different concept of “ownership” and “property” from the Western conception of these elements, with the former focusing on collectivity and community rather than who owns what, while the latter focuses on individual ownership and individual rights.<sup>127</sup> The concept of standing therefore follows the Western idea of ownership and individual rights, as demonstrated by such requirements as plaintiff being the aggrieved party that has been directly injured by the defendant’s conduct. When the claim asserted involves an indigenous community, issue of standing gets more complex. Is any member of the tribe the aggrieved party, or only the person that has a direct tie to the property in question?

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<sup>121</sup> 15 U.S.C. §1052(a) (2009).

<sup>122</sup> See *supra*, Part 2.2.2.

<sup>123</sup> 15 U.S.C. §1063 “[a]ny person who believes that he would be damaged by the registration of a mark [may] file an opposition . . .”.

<sup>124</sup> *Ritchie v. Simpson*, 170 F.3d at 1095.

<sup>125</sup> *Id.* at 1096.

<sup>126</sup> *Id.* at 1098.

<sup>127</sup> Green, *supra* note 109, at 350 (“indigenous populations are fundamentally more collective in their societal activities, they historically have a different sense of private property ownership . . .”).

A similar issue arose in an Australian case of *Onus v. Alcoa* before the High Court of Australia.<sup>128</sup> Plaintiffs in this case were members of a tribe who sought to enjoin the defendant from carrying out certain activities on the land that would interfere with the tribal relics.<sup>129</sup> The claim was brought under the Aboriginal Relics Preservation Act of 1972, which deems willful or negligent defacing of or damage to archaeological or aboriginal relics a criminal offense.<sup>130</sup> Lower court held plaintiffs lacked standing to sue.<sup>131</sup> On appeal the High Court mentioned that “the case is therefore one in which two private citizens who cannot show that any right of their own has been infringed bring an action for the purpose of restraining another private citizen (Alcoa) from breaking the criminal law . . . .”<sup>132</sup> The plaintiffs could not therefore rely on the Relics Act for standing. The court, however, stated that standing could also be based if plaintiffs have a special interest in the subject matter of the action, an interest in the lawsuit which the larger general public does not share.<sup>133</sup> The special interest test “is the proper one to apply in Australia and . . . appears to be similar to the test adopted in the United States.”<sup>134</sup> The plaintiffs in this case did have an interest greater than the members of the general public, as they would be “more particularly affected than other members of the Australian community by the destruction of the relics.”<sup>135</sup> The court also found significant that plaintiffs in this case were custodians of the relics according to tribal law and customs, and have used the relics to educate their children about the past. The court thus held that plaintiffs have standing in this case.

The finding of standing in the *Onus* case was based on the application of “special interest” test. However the “special interest” test, where one must have an interest that is greater than that of the general public, is broader than the requirement of the constitutional standing in the U.S. that the harm done by the defendant “must affect the plaintiff in a personal and individual way.”<sup>136</sup> Under the latter standard only the

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<sup>128</sup> *Onus v. Alcoa*, 149 CLR 27, 29 (Australia, 1981).

<sup>129</sup> *Id.* at 30.

<sup>130</sup> *Id.*

<sup>131</sup> *Id.* at 36.

<sup>132</sup> *Id.* at 35, Gibbs, C.J.

<sup>133</sup> *Onus v. Alcoa*, 149 CLR at 35-36.

<sup>134</sup> *Id.* at 44, Murphy, J., *citing* Australian Conservation Foundation Inc. v. The Commonwealth.

<sup>135</sup> *Onus v. Alcoa*, 149 CLR at 36, Gibbs, C.J.

<sup>136</sup> *Lujan*, 504 U.S. 55, Fn. 1.

plaintiff directly injured or a group where each member was individually and specially affected would have standing.

The question of standing, at least in the U.S., will largely depend upon the nature of the suit (e.g. copyright, trademark, or a common law equitable doctrine). For example, in *Harjo v. Pro-Football* the group of Native Americans that brought a cancellation proceeding was held to have standing because they possess “a trait or characteristic” that is directly implicated by the mark.<sup>137</sup> In effect this broader requirement of standing in the context of disparaging marks allows a claimant to assert group rights—any member of that group that is disparaged by the mark can bring an opposition or cancellation proceeding—which fits well with the concept of collective rights of the indigenous people. On the other hand, demonstration of standing would be more difficult in cases involving individual rights, such as copyright, where a member of a tribe who is not the artist or creator of the work tries to bring a claim in court. Because the issue of standing will vary depending upon the nature of the legal claim brought, it will be addressed in passing in the next individual sections discussing legal doctrines applicable to the protection of intangible cultural heritage.

### 3.2 Intellectual Property Laws

At first glance, intellectual property laws seem the most obvious choice of protection for intangible cultural heritage. At issue is the protection of intangible cultural works such as drawings and paintings, music and songs, storytelling and dance, all of which have traditionally been under the rubric of copyright law.<sup>138</sup> In addition at issue are also names of indigenous people, as was the case with Quileutes, along with symbols, images and traditional designs used in the course of trade—the subject matter generally under the purview of trademark law.<sup>139</sup> As discussed above, some scholars have

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<sup>137</sup> *Harjo v. Pro Football, inc.*, 30 U.S.P.Q.2d 1828 (Trademark Tr. & App. Bd. 1994); *see also* *Ritchie v. Simpson*, 170 F.3d at 1098 (“Native Americans who possessed the trait which was directly implicated in the proposed mark, REDSKINS . . . would also establish the reasonableness of their belief of damage.”).

<sup>138</sup> *See, e.g.*, *Haight Farley*, *supra* note 30, at 16.

<sup>139</sup> *See, e.g.* *Taylor Wine Co. v. Bully Hill Vineyards* 569 F.2d 731 (2d Cir. 1978), discussing that one’s name could be used in commerce as a trademark. *See also* *Wal-Mart Stores Inc. v. Samara Brothers, Inc.* 529 U.S. 205 (2000), stating in an action for infringement for unregistered trade dress, product design can

questioned the ability of intellectual property laws to offer protection for intangible cultural heritage, emphasizing the contrast between individual nature of intellectual property rights and the “collective rights that might best be used in such areas as folklore and traditional knowledge.”<sup>140</sup>

In addition, scholars who have considered whether intellectual property laws allow for proper protection of intangible cultural heritage have tended to focus on inadequacies of copyright law.<sup>141</sup> Oftentimes a conclusion arrived at is that copyright law alone is not adequate for intangible cultural heritage protection, mainly because key elements required for copyright protection may be missing: a single discernable author, originality, fixation, and if copyright ever existed, the problem of the work having fallen in the public domain due to time restrictions on copyright protection. However, copyright is not without problems when it comes to intangible cultural heritage protection, but it should not be completely ignored.

For example, group rights are not entirely alien to the framework of copyright law, as some have argued.<sup>142</sup> Indeed, there are a number of examples of intellectual property rights that are owned by groups. One example is a motion picture, which “may be the product of creative contributions from dozens or hundreds of directors, writers, actors, costumers, special effects technicians and more.”<sup>143</sup> Another example is computer software such as video games which likewise include a number of participants who have helped create the product.

Aside from copyright there are other protections under the intellectual property umbrella, which can sometimes fill in the gaps left open by copyright law. One

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be protected upon a showing of secondary meaning. The case involved children’s clothing with flower and fruit patches; the case could potentially be applied to fabric designs such as those of the mola discussed above.

<sup>140</sup> Graham & McJohn, *supra* note 1, at 328, discussing Michael F. Brown, Who Owns Native Culture? (2003).

<sup>141</sup> See, e.g. Slattery, *supra* note 3, at 229-43 (discussing economic and moral rights under copyright law); see also Angela R. Riley, *Recovering Collectivity: Group Rights to Intellectual Property in Indigenous Communities*, 18 CARDOZO ARTS & ENT. L.J. 175, at 179-97 (2000) (hereinafter Riley, *Recovering Collectivity*), discussing the issues of authorship, originality and fixation under copyright law.

<sup>142</sup> Graham & McJohn, *supra* note 1, at 328 (discussing criticisms of intellectual property laws to offer protection to intangible cultural heritage).

<sup>143</sup> *Id.* at 329.

example is trademark law, which has a concept of a collective mark, thus eliminating the problem of finding that elusive single owner of a work of cultural heritage.<sup>144</sup> Finally, one must not ignore related doctrines, including those of equity such as estoppel or quasi-contract in contract law along with unfair competition. The next section explores copyright law—including some successful examples of application of copyright law to grant protection to intangible cultural heritage—trademark law, and equitable remedies in turn.

### 3.2.1 Copyright

There are several requirements that must be met before copyright protection may be extended to a work. First, the work at issue must fall under the subject matter of copyright protection to qualify for such protection.<sup>145</sup> For instance the Berne Convention states that protected works under copyright law include literary and artistic works.<sup>146</sup> If a work falls under the subject matter of copyright protection, it must meet the following elements: authorship, originality, and fixation in some jurisdictions.<sup>147</sup> Once these elements are met, the copyright attaches as soon as the work is created even without formal registration. The time limitation on the copyright in most jurisdictions is life of the author plus seventy years.<sup>148</sup>

#### 3.2.1.1 Authorship

The authorship requirement may be an issue for intangible cultural heritage of the indigenous people. The notion of authorship under copyright law has been discussed by

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<sup>144</sup> *Id.* at 329-30.

<sup>145</sup> ADRIAN STERLING, *WORLD COPYRIGHT LAW* 610 (Sweet & Maxwell, 2003, 2nd ed.).

<sup>146</sup> Berne Convention Art. 2 (1971) stating that “the expression ‘literary and artistic works’ shall include every production in the literary, scientific and artistic domain, whatever may be the mode or form of its expression . . . .”

<sup>147</sup> *See, e.g.* U.S. Copyright Act, 17 U.S.C. §102 stating that copyright protection subsists in “original works of authorship fixed in any tangible medium of expression.” Fixation is a requirement only for some jurisdictions, including the U.S. Other jurisdictions have no fixation requirement. *See* Berne Convention Art. 2(2).

<sup>148</sup> Riley, *Recovering Collectivity*, *supra* note 141, at 186-87.

U.S. Supreme Court in *Burrow-Giles Lithographic Co. v. Sarony*.<sup>149</sup> The Court defined the term “author” as “he to whom anything owes its origin; originator; maker.”<sup>150</sup> Many of the works of intangible cultural heritage are quite old, long exceeding the limited time protection under copyright law. Because they are the product of collective knowledge, passed from generation to generation, a single author can rarely be identified. As the Enigma example illustrated, the original author is often either unknown or has been dead for centuries, and as a result the work is considered to be in the public domain.

Possible authorship classifications of intangible cultural heritage can include a work that has no known author (orphan work), which may be the case given that a true author of an indigenous song or tale may not in practice be traced, or a joint work of the entire tribe. With regard to orphan works, article 15(4) of the Berne convention leaves it up to the individual member states to enact legislation to create an authority to represent the author where the author is unknown.<sup>151</sup> Such work must not have been published, and the unknown author must be presumed to be the national of a country of the Berne Union.<sup>152</sup> However the Berne Convention still leaves unclear whether this language can be attributed to collective works or a just to works by a single unknown author.<sup>153</sup>

U.S. Copyright Act defines joint work as “a work prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole.”<sup>154</sup> It is not a requirement that to qualify for joint work the authors must have worked together in concert, just that there is an intention to create such joint work from the beginning.<sup>155</sup> Some have argued that this “non-linear” concept of joint authorship could be applied to intangible cultural heritage of the indigenous people which are developed together by a particular tribe and passed on from generation to

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<sup>149</sup> 111 U.S. 53 (1884). See La Voi, *supra* note 10, at 890.

<sup>150</sup> *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 58 (1884).

<sup>151</sup> Berne Convention Art. 15(4).

<sup>152</sup> *Id.*

<sup>153</sup> Cathryn A. Berryman, *Toward More Universal Protection of Intangible Cultural Property*, 1 J. INTELL. PROP. L. 293, 314 (1994).

<sup>154</sup> 17 U.S.C. § 101.

<sup>155</sup> La Voi, *supra* note 10, at 893.



generation.<sup>156</sup> Others have argued that the intent requirement to create a joint work from the beginning would render the concept of joint authorship inapplicable to indigenous intellectual property.<sup>157</sup> In addition, each joint “author” must qualify for authorship in her own right, as a result only those that can be identified as such would get protection for their contribution as a joint author.<sup>158</sup> Because of either the lack of intent or clearly identifiable authors, this concept is also problematic when applied to intangible cultural heritage.

Another possible classification of indigenous artistic or literary work for copyright purposes is that involving an individual author. In *Milpururru* and *Bulun Bulun* cases discussed above each Aboriginal artist held an individual copyright in his or her work. Indeed, this issue was hardly considered by the court as each painting had a clearly identifiable author, whether living or deceased. The court focused instead on other elements of a valid copyright, including originality. Classification of indigenous work as belonging to an individual author who created it, as was with the paintings in the Australian cases, would also resolve the problem of standing.

### 3.2.1.2 Originality

Originality requirement may pose additional questions. For instance, some have argued that because of the emphasis of indigenous art is its function as a historical or a sacred document, innovation by the individual artists is often restricted.<sup>159</sup> What is valued instead is the faithful reproduction of traditional designs depicting the tribal spiritual beliefs or history. As a result creativity is kept to a minimum, which may pose problems for the originality requirement under copyright law.<sup>160</sup>

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<sup>156</sup> *Id.*

<sup>157</sup> Riley, *Recovering Collectivity*, *supra* note 141, at 193.

<sup>158</sup> *Id.*

<sup>159</sup> Haight Farley, *supra* note 30, at 21-22.

<sup>160</sup> *Id.*

As the U.S. Supreme Court held in *Feist*, the “*sine qua non* of copyright is originality.”<sup>161</sup> However, the Court stated that originality does not mean novelty. Originality merely means the work is independently created—that is, the work must not have been copied from another work—and possesses minimal degree of creativity.<sup>162</sup> The Court held that “the requisite level of creativity is extremely low; even a slight amount will suffice. The vast majority of works make the grade quite easily, as they possess some creative spark, no matter how crude, humble or obvious it might be.”<sup>163</sup>

In *Milpurrurru*, the court addressed at length the question of originality of the Aboriginal paintings, particularly since the paintings depicting creation and dreaming stories were at least in part based on pre-existing traditions and images. But the court went on to state that although “the artworks follow traditional Aboriginal form and are based on dreaming themes, each artwork is one of intricate detail and complexity reflecting great skill and originality.”<sup>164</sup> The court stated that each painting was unique. In particular, of one painting the court stated that even though it used images that were “common western desert symbols as part of the design” it nevertheless did not prevent the final product from “having a high degree of originality.”<sup>165</sup> Thus even though the paintings were based on Aboriginal creations stories and dreamings, each artist’s individual interpretation of this imagery rendered their work original. This case demonstrates that issue of originality can be overcome with respect to indigenous cultural artworks by means of individual artistic choices by the artists.

### 3.2.1.3 Fixation

Fixation is another issue to consider with regards to intangible cultural heritage. Fixation is a constitutional requirement in U.S. copyright law,<sup>166</sup> although not elsewhere. There are a number of jurisdictions for which fixation is not a requirement,

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<sup>161</sup> *Feist Publications Inc. v. Rural Telephone Service Co., Inc.*, 499 U.S. 340, 345 (1991).

<sup>162</sup> *Id.*

<sup>163</sup> *Id.* (internal quotations omitted).

<sup>164</sup> *Milpurrurru and Others v. Indofurn Pty Ltd.* 54 FCR 240, 248 (1994).

<sup>165</sup> *Id.* at 262.

<sup>166</sup> The Copyright Clause of the U.S. Constitution states Congress is empowered to “promote the Progress of Science and the useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.” The Copyright Clause, U.S. Const. art. I, § 8, cl 8.

including many civil law countries. As a result, songs, folklore, designs, et cetera can exist without being fixed and still have legal protection. The only issue that can arise is that of proof of copyright ownership, which can be overcome by calling members of a tribe as witnesses, or expert witnesses. Furthermore, even in countries that do require fixation the meaning of the term is expanding. Particularly, the term fixation has been relaxed dramatically over the years in order to take into account advances in technology.

In *White-Smith Music Publishing v. Apollo* the U.S. Supreme Court has held that piano rolls were uncopyrightable because a work fixed in a copy that is not humanly readable is not subject to copyright protection.<sup>167</sup> The Court was simply unable to accept the idea that something that could only be read by a machine was copyrightable. This case was later struck down and protection was extended to piano rolls. As other technological innovations took place, in order to grant legal protection to new technology-based works courts had to reinterpret the term “fixation” accordingly. For instance, in *Williams Electronics v. Arctic International*, which involved alleged infringement of a video game, the defendant argued that the game was not “fixed” for purposes of copyright law, since its content and appearance can change depending upon individual player.<sup>168</sup> It was also argued that the game as a result could potentially generate new images with each new player.<sup>169</sup> The court has held that as long as the game was fixed in a tangible medium of expression from which it can be reproduced or communicated, whether directly or with an aid of a device, it had copyright protection.<sup>170</sup> Thus even if the video game changes depending on the player, it is still copyrightable.

Such expansion of the term fixation may also apply to certain works of indigenous intangible heritage that have some form of fixation, however transient. For works that remain unfixed, such as performances, other means of protection may be available with regard to performers’ rights.

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<sup>167</sup> *White-Smith Music Publishing Company v. Apollo Company*, 209 U.S. 1 (1908).

<sup>168</sup> *Williams Electronics, Inc. v. Arctic International Inc.*, 685 F.2d 870 (1982).

<sup>169</sup> *Id.* at 874.

<sup>170</sup> *Id.* at 873-74.

#### 3.2.1.4 Alternative Means of Protection of Unfixed Works

The fact that the work is not yet fixed may actually prove to be advantageous for indigenous intellectual property as the “copyright term of protection begins to run when an original work is fixed.”<sup>171</sup> This is particularly relevant to old works on which copyright would have run out. As a result, should indigenous people record works such as music or songs thereby fixing them in a tangible medium of expression, valid copyright could then subsist from the moment the works are recorded.

However, recording of intangible cultural heritage by their rightful owners to obtain copyright protection is of little use if the unfixed work had already been stolen, as was the case with Lifvon Guo’s chants. Some jurisdictions can offer redress in cases of unauthorized recording when the work is not fixed, including the United States. Under *U.S. v. Martignon*,<sup>172</sup> if a musical performance is not fixed, copyright-like right could be claimed under 18 U.S.C. 2319A, which prohibits “unauthorized recording of performances as well as the copying distribution, sale, rental, and trafficking of these bootlegged phonorecords.”<sup>173</sup> The statute has no time limitation. In the case, Martignon ran a business which sold unauthorized recordings of live performances by certain artists.<sup>174</sup> Upon the discovery of the sales, the Recording Industry Association of America (RIAA) then facilitated his arrest by the FBI under the statute. Martignon challenged the constitutionality of the statute, arguing that the work needs to be fixed in order to receive copyright protection under U.S. Copyright Act, and further, because the statute had no statute of limitations, it was in violation of the Copyright Clause of the U.S. Constitution which requires that protection be granted for limited time only. The Federal District Court struck down the statute as unconstitutional for these reasons.<sup>175</sup> However, on appeal to the 2<sup>nd</sup> Circuit the decision was reversed, and the court held that the statute was constitutional: the statute was properly enacted by Congress under its powers given to it by the Commerce Clause of the U.S. Constitution, not the Copyright

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<sup>171</sup> Haight Farley, *supra* note 30, at 29.

<sup>172</sup> 492 F.3d 140 (2007).

<sup>173</sup> *Id.* at 141.

<sup>174</sup> *U.S. v. Martignon* 346 F.Supp.2d 413, 417 (S.D.N.Y. 2004).

<sup>175</sup> *Id.* at 424.

Clause.<sup>176</sup> As a result, this statute can be applied to cases similar to that of Lifvon Guo, particularly since there is no time limitation, although it could not be applied to the case itself because of jurisdictional limitations.

In addition, under WIPO Performances and Phonographs Treaty (WPPT) of 1996, performers have the exclusive right in their own performances. Article 6 of the Treaty states that performers “shall enjoy the exclusive right of authorizing, as regards their performances: (i) the broadcasting and communication to the public of their unfixed performances except where the performance is already a broadcast performance; and (ii) the fixation of their unfixed performances.”<sup>177</sup> France, which is a signatory to the treaty,<sup>178</sup> could thus be held accountable for the unauthorized fixation of Lifvon Guo’s voice. But because Taiwan is not a signatory, Lifvon Guo is not protected since under the treaty the contracting states are bound to give protection under the treaty only to the performers of other contracting states.<sup>179</sup> However, the case of Lifvon Guo is a complex cross-jurisdictional dispute. The effect of these two statutes should not be underestimated as in relevant circumstances both Title 18 U.S.C. 2319A and WPPT could be used to prevent unauthorized recordings of unfixed performances of indigenous works.

### 3.2.2 Trademark Law

Trademark law is distinguishable from other areas of intellectual property law in that it does not protect an intangible asset per se, rather it protects the trade activity associated with that asset.<sup>180</sup> Trademark law protects the use of a particular mark or design in the course of trade, not the mark or design itself (although it may qualify for copyright protection on its own, depending on the originality of the design).<sup>181</sup> It is further

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<sup>176</sup> U.S. v. Martignon, 492 F.3d. 140 (2007).

<sup>177</sup> WIPO Performances and Phonograms Treaty Art. 6 (1996).

<sup>178</sup> See WIPO, [http://www.wipo.int/treaties/en/SearchForm.jsp?search\\_what=C](http://www.wipo.int/treaties/en/SearchForm.jsp?search_what=C).

<sup>179</sup> WIPO Performances and Phonograms Treaty Art. 3(1) (1996).

<sup>180</sup> Paterson & Karjala, *supra* note 107, at 667.

<sup>181</sup> See, e.g., 15 U.S.C. 1051(a)(1) stating that “[t]he owner of a trademark *used in commerce* may request registration of its trademark on the principal register” (emphasis added), Council Regulation (EC) No 207/2009 on the Community trade mark, Art. 9(1) stating “[t]he proprietor shall be entitled to prevent all third parties not having his consent from using in the *course of trade* . . . .” (emphasis added);

distinguishable from other types of intellectual property protection, such as copyright and patent which grant protection for a limited time, by the fact that as long as the trademark remains in use and does not become generic, trademark protection can last indefinitely. Another advantage of trademark protection is that it does not have some of the same problems of standing that for example copyright law may have with regard to who has the right to bring a lawsuit for infringement of intangible cultural heritage. It is for these reasons that trademark law, in combination with copyright law, may provide adequate means of protection to certain types of intangible cultural heritage.<sup>182</sup>

### 3.2.2.1 Deceptive Marks

Trademarks or trade dress items that are deliberately marketed as indigenous but are actually produced by companies that mass-produce the products in a factory may be particularly detrimental to indigenous people. Deceptive marks are detrimental in cases where indigenous people have established a trade where they sell some of their traditional designs to for example tourists, thus establishing a source of income for their community which in some cases may be a significant portion of their livelihood. Making traditional designs by the indigenous people involves time and effort. However if a non-indigenous competitor decides to copy that design and manufacture the product at a lower cost and establish a competing trade, thus undercutting the indigenous trade, indigenous people may be able to get redress through the application of trademark law.

The U.S. Lanham Act applies to both registered and unregistered marks. Section 32 allows actions for infringement of registered marks.<sup>183</sup> Section 43(a) of the Lanham Act gives rise to a cause of action for infringement of unregistered marks, prohibiting false designation of origin.<sup>184</sup> False designation of origin would have application to deceptive marketing of indigenous designs when they are being passed off as having

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*see also* Directive 2008/95/EC to approximate the laws of the Member States relating to trade marks, Art.5. Although an application may be filed prior to actual use, there must be intent to use that mark in the course of trade.

<sup>182</sup> Haight Farley, *supra* note 30, at 50.

<sup>183</sup> 15 U.S.C. §1114.

<sup>184</sup> 15 U.S.C. § 1125(a)(1)(A). *See* Zazu Designs v. L’Oreal, S.A. 979 F.2d 499 (7th Cir. 1992) (“Through §43(a) of the Lanham Act, 15. U.S.C. §1125(a), a provision addressed to deceit, [federal law] allows the enforcement of unregistered marks.”).

been made by indigenous people when they indeed were not. This section would therefore allow a Native American tribe or a representative thereof to bring an infringement action even if the mark or design in question is not federally registered against a non-Native American using that particular mark, provided certain other conditions are met.<sup>185</sup>

The language of Section 43(a) is rather loose, stating that anyone who uses a mark as a false designation of origin will be civilly liable to any person “who believes that he or she is or is likely to be damaged by such act.”<sup>186</sup> The plain language of the statute does not require the same association as for example between the specific work and the author that copyright law mandates, nor does it require that the mark in question be specifically used by a person trying to assert their rights; it is simply a requirement of a belief of damage by the infringing act.<sup>187</sup> As a result the statute is able to provide a remedy to a member of an indigenous tribe who is not specifically associated with that mark (for example, who is not the maker of the design or the product in question) but who nevertheless will be damaged by another’s use of that mark.<sup>188</sup> Trademark law, because of its rather unique qualities in relation to other intellectual property rights, is therefore able to provide greater and more easily attainable protection for qualifying works of the indigenous people.

In addition to the protection afforded by Section 43(a) of the Lanham Act, the USPTO also affords specific protection to Native American Tribes with respect to their official insignia. In 1998, President Bill Clinton signed Public Law 105-330, which mandated the USPTO to study how official Native American insignia may be protected under trademark law more effectively.<sup>189</sup> Official insignia of Native American Tribes is defined as “the flag or coat of arms or other emblem or device of any federally or State

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<sup>185</sup> In case of unregistered marks, use in commerce would have to be proved. *See, e.g. Zazu Designs v. L’Oreal S.A.* 979 F.2d 499 (7<sup>th</sup> Cir. 1992).

<sup>186</sup> 15 U.S.C. 1125(a)(1).

<sup>187</sup> The courts have interpreted this section as requiring only “proof providing a reasonable basis for the belief that the plaintiff is likely to be damaged” and no proof of actual damage is required. *Johnson & Johnson v. Carter-Wallace, Inc.* 631 F.2d 186 (2d Cir. 1980).

<sup>188</sup> *See id.* (stating that the statute entitles a broad range of parties to relief).

<sup>189</sup> Gavin Clarkson, *Racial Imagery and Native Americans: a First Look at the Empirical Evidence Behind the Indian Mascot Controversy*, 11 CARDOZO J. INT’L & COMP. L. 393 (2003), *see also* U.S. Pat. & Trademark Off., Report on the Official Insignia of Native American Tribes (1999) (hereinafter USPTO study), available at [www.uspto.gov/web/offices/com/sol/notices/insgstdy.pdf](http://www.uspto.gov/web/offices/com/sol/notices/insgstdy.pdf).

recognized Native American tribe, as adopted by tribal resolution and notified to the U.S. Patent and Trademark Office.”<sup>190</sup> The study found that USPTO provides substantial protection against misrepresentation of Native American produced goods.<sup>191</sup> Particularly, since 1994 the USPTO has taken steps to examine trademark applications “containing tribal names, recognizable likenesses of Native Americans, symbols perceived as being Native American in origin, and any other application which the PTO believes suggests an association with Native Americans” with special scrutiny and refuse registration of such marks if there is any indication of false association with Native Americans or their possible disparagement.<sup>192</sup>

The study also points to the Indian Arts and Crafts Act of 1935<sup>193</sup> as another avenue of protection against the misrepresentation in marketing of Native American arts and crafts. The Act makes it both a civil and criminal violation to offer or display for sale of “any good . . . in a manner that falsely suggests it is Indian produced, an Indian product, or the product of a particular Indian or Indian tribe or Indian arts and crafts organization, resident within the United States.”<sup>194</sup> The criminal violation entails both a fine and imprisonment.<sup>195</sup> A civil action may also be brought, in which case the plaintiff may be entitled to injunctive relief and treble damages along with punitive damages.<sup>196</sup> The Act specifically states that among the persons entitled to bring a civil action may be “an Indian tribe on behalf of itself, an Indian who is a member of the tribe, or on behalf of an Indian arts and crafts organization”<sup>197</sup> thus giving standing to the specific Native American tribe or a representative of that tribe. The Act also establishes the Indian Arts and Crafts Board which may register trademarks and bring an action for trademark infringement on behalf of federally recognized Native American tribes.<sup>198</sup> Overall it seems, with both criminal prosecution and ability to bring

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<sup>190</sup> USPTO Study, *supra* note 189.

<sup>191</sup> *Id.*

<sup>192</sup> *Id.*

<sup>193</sup> 25 U.S.C. §305 *et seq.*

<sup>194</sup> 25 U.S.C. §305e(a) (civil violation), 18 U.S.C. §1159 (criminal violation).

<sup>195</sup> 18 U.S.C. §1159(b) (imposing a maximum fine of \$250,000 and/or imprisonment for a maximum term of five years for the first violation and up to \$1,000,000 in fines and maximum term of imprisonment of fifteen years for any subsequent violations).

<sup>196</sup> 25 U.S.C. §305e(a), (b).

<sup>197</sup> 25 U.S.C. §305e(c)(1)(B).

<sup>198</sup> 25 U.S.C. §305(g)(3), (4).



a civil cause of action by individuals, the protection offered by the Indian Arts and Crafts Act is substantial with respect to misrepresentation of Native American goods.

The USPTO study concluded as a result of both its internal procedures with regard to Native American insignia and Indian Arts and Crafts Act, further legislation in this area of law is unnecessary, but it recommended for an establishment of a comprehensive database of official Native American insignia.<sup>199</sup> Such database was subsequently established.<sup>200</sup> The study further concluded that “existing trademark law provides the legal tools necessary to prohibit registration of ‘official insignia’ or simulations thereof, where the applicant is not the Native American tribal owner.”<sup>201</sup> For example, one application for “Zia” mark to be used in connection with cocktail mixes was refused on the ground that it would give false association with the Pueblo of Zia, and because of the nature of the product could be perceived as “possible disparagement of the tribe.”<sup>202</sup>

Unfortunately the *Harjo* decision discussed above falls outside the scope of the protection discussed in the study. The study specifically stated that the issues raised by the *Harjo* decision “fall in the category of ‘other social ills’ which may have trademark implications, but do not involve ‘official insignia of Native American tribes’”<sup>203</sup> as the term “Redskins” is not an emblem adopted by any tribe.

Furthermore the Indian Arts and Crafts Act and the USPTO policy with regard to official Native American insignia are only applicable to products where there is a possibility of false association between the product and a particular tribe. That is, when the product sold is claimed to be made by or somehow associated with Native Americans. Some of the criticism of U.S. trademark protection of intangible cultural heritage is that it would not “prevent non-indigenous persons from making new

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<sup>199</sup> USPTO Study, *supra* note 189.

<sup>200</sup> Establishment of a Database Containing the Official Insignia of Federally Recognized Native American Tribes, 66 Fed. Reg. 6 1649 (2001), see also, Clarkson, *supra* note 189, at 406.

<sup>201</sup> USPTO Study, *supra* note 189 at 44.

<sup>202</sup> *Id.*, discussing Application Serial No. 75-447770 for the mark “Zia” with Zia Sun Symbol design.

<sup>203</sup> USPTO Study, *supra* note 189.

products that merely incorporate indigenous motifs. As long as these products are not marketed as ‘Indian made,’ they will be permitted.”<sup>204</sup>

### 3.2.2.2 Disparaging Marks

The *Harjo* case discussed in Part 2 puts a heavy burden on Native Americans to diligently search new registrations of potentially disparaging marks and bring cancellation proceedings as soon as possible. Despite the fact that the registration of the disparaging mark still stands, however, the *Harjo* case nevertheless serves as an important precedent for similar cases that may arise in the future. First, under Section 2(a) of the Lanham Act, no intent to disparage is needed; the mere fact of disparagement to the group as perceived by that group is enough.<sup>205</sup> Second, the decisions clarify that in order for there to be a cancellation under disparagement, a “substantial composite” of the group must perceive it as disparaging.<sup>206</sup> Third it stands for the proposition that though the laches defense may bar older members of the group from bringing the petition, since laches begins to run only from the date of the petitioner’s majority, younger members of the group may still bring the cancellation proceeding.<sup>207</sup>

Despite the ruling in this particular case, what is important is that the cancellation on the basis of disparagement *is* available for Native Americans. If new registrations were filed today that would be perceived as disparaging by Native Americans, the cancellation (or opposition) applications may then be filed. Indeed the District Court was careful to point out on two separate occasions that the decision itself made no statement on the appropriateness of derogatory use of such names.<sup>208</sup>

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<sup>204</sup> Haight Farley, *supra* note 30, at 51-52.

<sup>205</sup> *Harjo II*, 50 U.S.P.Q.2d at 1738.

<sup>206</sup> *Id.* at 1739.

<sup>207</sup> *Harjo V*, 415 F.3d at 48.

<sup>208</sup> *Harjo IV*, 284 F.Supp.2d at 144-45, *Harjo VI*, 567 F.Supp.2d at 62.

### 3.2.2.3 Certification and Collective Marks

Both certification and collective marks can be used by groups, and as a result they can be used to protect group rights of the indigenous people.<sup>209</sup> There is some evidence that such use of the marks is increasing among indigenous people.<sup>210</sup> Under the U.S. Lanham Act, a collective mark is defined as a mark “used by the members of a cooperative, an association, or other collective group or organization . . . and includes marks indicating membership in a union, an association, or other organization.”<sup>211</sup> A certification mark is used by a person “to certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of such person’s goods or services or that the work or labor on the goods or services was performed by members of a union or other organization.”<sup>212</sup> As a result, certification marks may prove to be particularly important for indigenous intangible cultural heritage.

Indigenous designs are becoming more and more popular in the main stream culture. From Native American bracelets to Aboriginal designs printed on T-shirts and rugs, there is a growing demand for products with native or tribal patterns, images and symbols. However it may nevertheless be important to the consumers buying these products to know that these products indeed come from a legitimate source. For instance, the artists in *Milpurrurru* case were alerted as to the infringement of their art by a would-be buyer of the rugs who wanted to ensure that the rugs had a legitimate copyright license before purchasing them.<sup>213</sup> A person buying a bracelet with a Native American motif might want to know that it was made by a Native American, and not mass-produced in an Asian sweat shop. The official Quileute e-commerce store encourages the consumer to “be authentic.”<sup>214</sup> Indeed, authenticity “has already been recognized as an important tool in the protection of intangible goods.”<sup>215</sup> Certification marks have the ability to assure the buyer that the product comes from a legitimate

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<sup>209</sup> Graham & McJohn, *supra* note 1, at 329.

<sup>210</sup> *Id.* at 330.

<sup>211</sup> US Lanham Act, 15 U.S.C. § 1127.

<sup>212</sup> *Id.*

<sup>213</sup> *Milpurrurru and Others v. Indofurn*, 54 FCR 240, 252 (1995).

<sup>214</sup> <http://www.quileute-store.com/index.php>.

<sup>215</sup> Paterson & Karjala, *supra* note 107, at 667.

source.<sup>216</sup> They can also be used to assure the buyer the product comports with particular standards adopted by the manufacturer.<sup>217</sup> Thus the affixation of a certification mark may be used by indigenous people to certify that a product is indeed a genuine product.

### 3.3 Unfair Competition and Related Rights

This section discusses unfair competition and other equitable doctrines in existence in common law jurisdictions which may be used to fill some of the gaps in intellectual property protection of intangible cultural heritage. Creating new legal regimes to patch the gaps in intellectual property protection of intangible cultural heritage may pose more problems rather than solutions. Indeed it may cause “fundamental conflicts between cultural heritage protection and the basic notions of free expression in democratic societies that are the underlying policy basis for the limitations we find in the current IPR regimes.”<sup>218</sup> Intellectual property protection is typically granted for a limited time to give the author or inventor of a work incentive to share that work with the public, without the fear that someone else might take credit for it or financially benefit from it. However this protection is also balanced with the notion that the work should eventually enter public domain for new authors to create new works and inventions based on preexisting works.<sup>219</sup> Making new legal regimes to allow perpetual protection of intellectual property may face unconstitutionality challenges in some jurisdictions, such as the U.S. where the Constitution expressly states protection to copyrightable and patentable works is to be extended for a limited time.

For some of the same reasons the doctrine of unfair competition and other equitable doctrines such as quasi-contracts can fit nicely with intellectual property law to extend adequate protection to intangible cultural heritage without the need for new sui generis intellectual property law. Equitable doctrines have traditionally been used by courts to rectify an imbalance created when a stronger party takes advantage of the weaker one

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<sup>216</sup> *Id.* at 667.

<sup>217</sup> Graham & McJohn, *supra* note 1, at 329.

<sup>218</sup> Paterson & Karjala, *supra* note 107, at 662.

<sup>219</sup> Graham & McJohn, *supra* note 1, at 324-25.

and unjustly profits as a result. They have also been used to correct cases of fundamental unfairness, when remedy is lacking in the current law. Such imbalance and unfairness occurs for example when a party gains the trust of indigenous people to obtain certain medicinal knowledge known only to that tribe to then reap profits from that knowledge by making a new patent. As will be discussed below, this injustice may be corrected by the means of equity. Such “more modest” alternatives to new legislation in this area may not only solve some of the problems left open by intellectual property law, it would also generate much less tension with fundamental principles behind intellectual property rights.<sup>220</sup>

### 3.3.1 Right of Publicity

The right of publicity is applicable to cases of appropriation of a person’s name or image to be used to advertise the appropriator’s product or service. The right of publicity has been described as the “inherent right of every human being to control the commercial use of his or her identity.”<sup>221</sup> It is considered to be a tort of invasion of privacy and consists of three elements that must be met: defendant appropriated the plaintiff’s name or likeness for the value associated with it, the plaintiff can be identified from the publication at issue and there was some advantage or benefit to the defendant.<sup>222</sup> Although the doctrine could potentially be applied to the use of an image of, for example, a Native American without his or her consent for purposes of advertising, in the past this doctrine has been applied by courts to protect the commercial interest of celebrities.<sup>223</sup> It is therefore questionable whether it can be used to appropriation of the image of an indigenous person or a tribe in advertising unless that person or tribe are well known and possess commercial value in their identity. However this issue of first impression may still be entertained by a court.

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<sup>220</sup> Paterson & Karjala, *supra* note 107 at 662.

<sup>221</sup> J. Thomas McCarthy, *Melville B. Nimmer and the Right of Publicity: A Tribute*, 34 U.C.L.A. L.REV. 1703, 1704 (1987).

<sup>222</sup> *Henley v. Dillard Department Stores*, 46 F. Supp. 2d 587 (N.D. Tx. 1999).

<sup>223</sup> *See, e.g. Henley v. Dillard Department Stores*, 46 F. Supp. 2d 587 (N.D. Tx. 1999) (involving the appropriation of the image of Donald Hugh Henley, the founder of the Eagles), *Midler v. Ford Motor Co.*, 849 F.2d 460 (1988) (involving the use of Bette Middler’s voice in a commercial).

### 3.3.2 Misappropriation

The doctrine of misappropriation has been first applied by U.S. Supreme Court in *INS v. Associated Press*.<sup>224</sup> At issue was that INS, a competitor of Associated Press, was taking news reports published by Associated Press and using them without payment. No copyright subsisted in the news as they were effectively uncopyrightable facts. The court found that INS had nonetheless engaged in unfair competition by using the reports published by Associated Press.<sup>225</sup> The court held that the defendant was “taking material that has been acquired by complainant as the result of organization and the expenditure of labor, skill, and money, and . . . is endeavoring to reap where it has not sown.”<sup>226</sup> Since this decision, the application of this doctrine has been limited to “hot-news” or information that is highly time-sensitive taken by a party in direct competition with the plaintiff.<sup>227</sup>

Even though this doctrine has been limited, its implications for the rights of indigenous people are still important. In *INS v. Associated Press* the court was able to extend protection to uncopyrightable information—facts—that had commercial value. Indeed, it seems at least “the spirit of the misappropriation doctrine in the INS case seems consistent with indigenous misappropriation claims.”<sup>228</sup>

### 3.3.3 Quasi-Contract and Equitable Estoppel

The quasi-contract may be applied to cases of appropriation of potentially commercially valuable indigenous knowledge. Knowledge or facts are generally not subject to intellectual property protection. There is evidence that traditional knowledge of indigenous people, especially medicinal knowledge, has been widely exploited. For example, when pharmaceutical researchers utilize indigenous knowledge of medicinal qualities of certain plants, the possibility of developing at least one marketable drug

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<sup>224</sup> *International News Service v. Associated Press*, 248 U.S. 215 (1918).

<sup>225</sup> Paterson & Karjala, *supra* note 107, at 659.

<sup>226</sup> *International News Service v. Associated Press*, 248 U.S. 215 (1918).

<sup>227</sup> *National Basketball Association v. Motorola, Inc.*, 105 F.3d 841 (2d Cir. 1997).

<sup>228</sup> Paterson & Karjala, *supra* note 107, at 659.

increases from twenty-two to seventy eight percent.<sup>229</sup> Moreover, twenty-five percent of all prescription drugs in the United States contain an active ingredient that is derived from indigenous medicinal knowledge of plants. There is therefore no question about the enormous financial value of indigenous knowledge of medicinal qualities of certain plants.

It is unlikely that the medicinal plant knowledge would qualify for patent protection as such knowledge would be deemed a discovery rather than an invention. Scientists at pharmaceutical companies, however, have the technological capacity to extract the particular compound from the plants and manufacture a drug qualifying for patent protection, thus gaining the legal protection of patent law under which indigenous people would have no remedy. However, the quasi-contract, which is “an equitable notion of unjust enrichment related to breach of a confidential relationship”<sup>230</sup> may be applicable in such situations. It is generally applied to cases where there has been a conferral of a benefit on the defendant—such as obtaining valuable information—who is then enriched as a result of that benefit, especially where there was undue advantage taken of the plaintiff. Such undue advantage may occur for instance if the defendant obtained the requisite information through misrepresentation or in bad faith with the intent to profit from that information.<sup>231</sup> This doctrine has been applied to cases where a person supplies an idea for a motion picture, and that idea is then used to make a film without compensation to the supplier.<sup>232</sup> By extension it could thus also be applied to indigenous “ideas” for a patentable drug. However this doctrine is also problematic: it is decided on a case-by-case basis and as a result is not applied uniformly.<sup>233</sup>

### 3.3.4 Trade Secrets and the Duty of Confidence

Knowledge that is possessed only by a small group of individuals and is therefore not known to the public may be subject to trade secret protection. Trade secret law is

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<sup>229</sup> Chidi Oguamanam, *Localizing Intellectual Property in the Globalization Epoch: The Integration of Indigenous Knowledge*, 11 IND. J. GLOBAL LEGAL STUD. 135 (2004).

<sup>230</sup> Paterson & Karjala, *supra* note 107, at 663-64.

<sup>231</sup> *Id.*

<sup>232</sup> *Id.* at 663.

<sup>233</sup> *Id.* at 664.

generally applicable to commercially valuable information that is kept in confidence and is used in business.<sup>234</sup> However, a related common law doctrine of breach of the duty of confidence with respect to intangible cultural heritage has been applied by an Australian court in *Foster v. Mountford*.<sup>235</sup> The plaintiffs were members of an Aboriginal community called the Pitjantjara people who sought an interlocutory injunction to prevent the publication of defendants' book, *Nomads of the Australian Desert*.<sup>236</sup> The defendants in this case were the book's author, Mountford, and the book's publisher.<sup>237</sup>

The plaintiffs argued that thirty-five years prior to the proceedings, Mountford came to their area to collect anthropological information.<sup>238</sup> During his exploration he was taken into the confidence of the Pitjantjara people, who showed and explained to Mountford and his crew the secrets of their people, including sacred grounds, objects, as well as art.<sup>239</sup> Much of this information was later published in Mountford's book, revealing the secrets of the Pitjantjara people.<sup>240</sup> According to the customs of the Pitjantjara people, some of the secrets revealed in the book could not be revealed to "women, children and uninitiated men" of the tribe, and their revelation in the book could thus cause grave harm to the Pitjantjara community.<sup>241</sup> The book contained a disclaimer that where Australian aborigines were concerned, this book should only be used after consultation with the religious leaders of the tribe, however the book was freely available for sale to the public.<sup>242</sup>

The court found that the plaintiffs demonstrated "a genuine fear that the book may further disrupt their social system" as the secrets may "be revealed to those to whom it was always understood it would not be revealed."<sup>243</sup> The court also found that the

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<sup>234</sup> See, e.g. *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470 (1974).

<sup>235</sup> *Foster v Mountford* (1976) 29 FLR 233 (Austl.)

<sup>236</sup> *Id.* at 234.

<sup>237</sup> *Id.*

<sup>238</sup> *Id.* at 235.

<sup>239</sup> *Id.*

<sup>240</sup> *Foster v Mountford*, 29 FLR at 235.

<sup>241</sup> *Id.* at 236.

<sup>242</sup> *Id.* at 235.

<sup>243</sup> *Id.* at 236-37.



information contained in the book could only have been communicated in confidence that Mountford himself accepted at the time of its revelation.<sup>244</sup>

The court, in considering whether the injunction should be granted, relied on the principles of equity rather than law. The court wrote that “it is quite clear that, independently of any question as to the right at law, the Court of Chancery always had an original and independent jurisdiction to prevent what the court considered and treated as a wrong . . . .”<sup>245</sup> The court held that plaintiffs have established a prima facie case that defendant’s conduct was the breach of the duty of confidence and issued an interlocutory injunction.<sup>246</sup> The court also briefly considered the issue of standing, stating that plaintiffs here “sue on their own behalf, not merely as members or representatives of the Pitjantjara people . . . . They allege that they, as individuals are threatened with damage” and as a result the plaintiffs were “entitled to bring this action in its present form.”<sup>247</sup> Although this case only considered the question with regard to issuing an interlocutory injunction, and other issues such as plaintiffs’ entitlement to damages were not considered, it still demonstrates that courts are prepared to use the principles of equity to arrive at just results for indigenous people.

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<sup>244</sup> *Id.* at 235.

<sup>245</sup> *Foster v Mountford*, 29 FLR at 237.

<sup>246</sup> *Id.* at 237-38.

<sup>247</sup> *Id.* at 238.

## 4 Additional Solutions: WIPO and Digital Documentation

The efforts of World Intellectual Property Organization (WIPO) with respect to protection of intangible cultural heritage have been considerable. For example in 1998, it began exploring intellectual property needs and expectations of traditional knowledge holders all over the globe.<sup>248</sup> In 2000 it set up the Inter-governmental Committee on Genetic Resources, Traditional Knowledge and Folklore. The committee has conducted a comprehensive survey on existing forms of intellectual property protection of traditional knowledge.<sup>249</sup> More recently, WIPO has been making efforts to promote digital documentation of intangible cultural heritage.

Digital documentation of intangible cultural heritage by the indigenous communities can patch some of the gaps in copyright protection of indigenous cultural heritage. In particular, digital documentation can resolve the problem of lack of fixation or identifiable author, and therefore constitutes an additional avenue of protection for indigenous people, supplementing the means of protection discussed above.

### 4.1 Advantages of Digital Documentation

Digital documentation is defined as the use of software, technology and digital rights management tools to document and record intangible cultural heritage.<sup>250</sup> Creation of databases of digitally recorded indigenous works can then be compiled. Such documentation would allow indigenous people to not only preserve indigenous intellectual property for future generations, but also have the requisite legal means to protect it against infringement. Specifically, it would fill some of the gaps in copyright

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<sup>248</sup> Oguamanam, *supra* note 229, at 158.

<sup>249</sup> *Id.* at 159-62.

<sup>250</sup> Stephanie Spangler, *When Indigenous Communities Go Digital: Protecting Traditional Cultural Expressions Through Integration of IP and Customary Law*, 27 CARDOZO ARTS & ENT. L.J. 709, 722-23 (2010).

law with respect to intangible cultural heritage including lack of fixation and authorship with regard to native performances such as music, song, and choreography.<sup>251</sup> The digital recording of such works on a tangible medium would provide the requisite element of fixation. In addition once a particular indigenous community digitally documents their intangible cultural heritage “the copyright of the recordings of the digital databases vest in the indigenous communities because they become the ‘author’ or creator of the documentations.”<sup>252</sup>

WIPO offers assistance and advice to communities “wishing to record, digitize and disseminate their traditional music, performances, art, designs and other creative expressions of traditional cultures for safeguarding, promotional and commercial purposes.”<sup>253</sup> In particular, WIPO is interested in providing communities with information with regard to how to identify and manage their intellectual property rights. Proper IPR management requires relevant intellectual property information about each recording. “This information, for example, identifies the recording, the holder(s) of rights in the recording, and any usage rules associated with the recording, including rules derived from customary laws and practices.”<sup>254</sup> IPR management as a result can prevent misappropriation or misuse of the recorded intangible cultural heritage.<sup>255</sup> WIPO also maintains a list of digital recording databases maintained by communities through its Creative Heritage Digital Gateway. Individual communities may be contacted through this Gateway for information or for permission to use these recordings.<sup>256</sup>

Digital recording of intangible cultural heritage would give notice to the public with regard to copyright ownership of the relevant work and would also enable indigenous communities to have greater self-determination and control with regard to who can be granted the right to use such works.<sup>257</sup> In addition to providing the missing elements

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<sup>251</sup> *Id.*

<sup>252</sup> *Id.*

<sup>253</sup> WIPO, Creative Heritage Digital Gateway, <http://www.wipo.int/tk/en/culturalheritage/gateway/> (last visited May 12, 2010).

<sup>254</sup> *Id.*

<sup>255</sup> *Id.*

<sup>256</sup> *Id.*

<sup>257</sup> Spangler, *supra* note 250, at 722.

under copyright law and therefore granting such work copyright protection, digitally documented works may also benefit from the legal protection of digital rights management systems.<sup>258</sup>

## 4.2 Potential Challenges and Implications for the Future

There may be some problems with viability of implementing a system of digital documentation of indigenous intangible cultural heritage. One of such problems is cost: as both documenting and creating a comprehensive database of such work is extremely expensive, it may be outside of the financial capacity of indigenous people. Another such problem is that it may actually result in more infringement, as a greater amount of indigenous works would be publicly available. However, some have argued that this risk of misappropriation should not deter indigenous communities from using this tool, as software and digital rights management tools can adjust to meet the needs of indigenous communities by means of defining and controlling the rights and accessibility to the digital recordings.<sup>259</sup> What is particularly significant is that digital documentation of intangible cultural heritage “shows how a modern, technological tool can be converged with traditional culture.”<sup>260</sup>

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<sup>258</sup> This can be accomplished using laws which protect against circumvention of digital rights management systems.

<sup>259</sup> Spangler, *supra* note 250, at 722.

<sup>260</sup> *Id.*

## 5 Conclusion

The debate whether the current law is sufficient to grant adequate protection to indigenous people versus arguments for new legislation is a continuing one. Before efforts are made at implementing new law in this area, all the legal tools currently available must be carefully evaluated. Some indigenous intellectual property can be effectively protected by intellectual property law, as long as it meets all of the required elements.<sup>261</sup> For example, copyright law has been applied effectively for Aboriginal paintings, but it may not be sufficient with regards to unfixed works such as oral traditions, live performances and songs. As a result, intellectual property laws alone may not be sufficient to extend protection to indigenous intangible cultural heritage in every instance. In instances where intellectual property protection fails, the doctrine of equity and unfair competition may be used to fill some of the gaps. Some courts, such as the Australian courts in *Milpurrruru*, *Bulun Bulun*, and *Foster* cases have already began applying equitable doctrines to extend protection to Aboriginal works. Other common law jurisdictions may look to Australian courts in terms of application of these doctrines to intangible cultural heritage as persuasive authority.<sup>262</sup> In addition, digital documentation of intangible cultural heritage may also be used to fill some of the gaps in intellectual property law to extend protection to intangible cultural heritage.

Furthermore, there is a balance between free information and proprietary rights. Culture exists in part so that new works can be built off of it. Intellectual property laws exist to encourage this development—to grant protection to new works for a limited time until those works themselves fall into public domain. On the one hand not all cultural works should be protected because this would significantly hinder further cultural development. However it is also fundamentally unfair to exploit indigenous

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<sup>261</sup> *Id.* at 720.

<sup>262</sup> Some concepts discussed in this thesis, such as unfair competition, concern primarily the legal protection available in common law jurisdictions. It is thus important to note that the means of protection of indigenous cultural heritage discussed here may not be appropriate for all jurisdictions (i.e. civil law countries).

cultures so that others can maliciously profit to the detriment of indigenous people. Such exploitation, examples of which were discussed earlier, certainly cannot be what was intended by the delicate balance struck between intellectual property rights and freedom of information.

On the other hand, to grant *sui generis* rights to indigenous heritage may present problems of its own. Some such laws propose indefinite copyright protection, which in some jurisdictions is unconstitutional. This also goes against the grain of the balance of intellectual property protection and freedom of information. As a result a blanket protection for indigenous cultural works by virtue of *sui generis* rights may upset this balance, while using already existing law will not. Because many of the legal concepts discussed above involve equity, a judge would have it in her discretion to consider all the circumstances in each case to maintain such balance.

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